

(16,188 & 16,189.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1897.

No. 130.

**MCCORMICK HARVESTING MACHINE COMPANY,
APPELLANT,**

vs.

C. AULTMAN & COMPANY ET AL.

No. 131.

**MCCORMICK HARVESTING MACHINE COMPANY,
APPELLANT,**

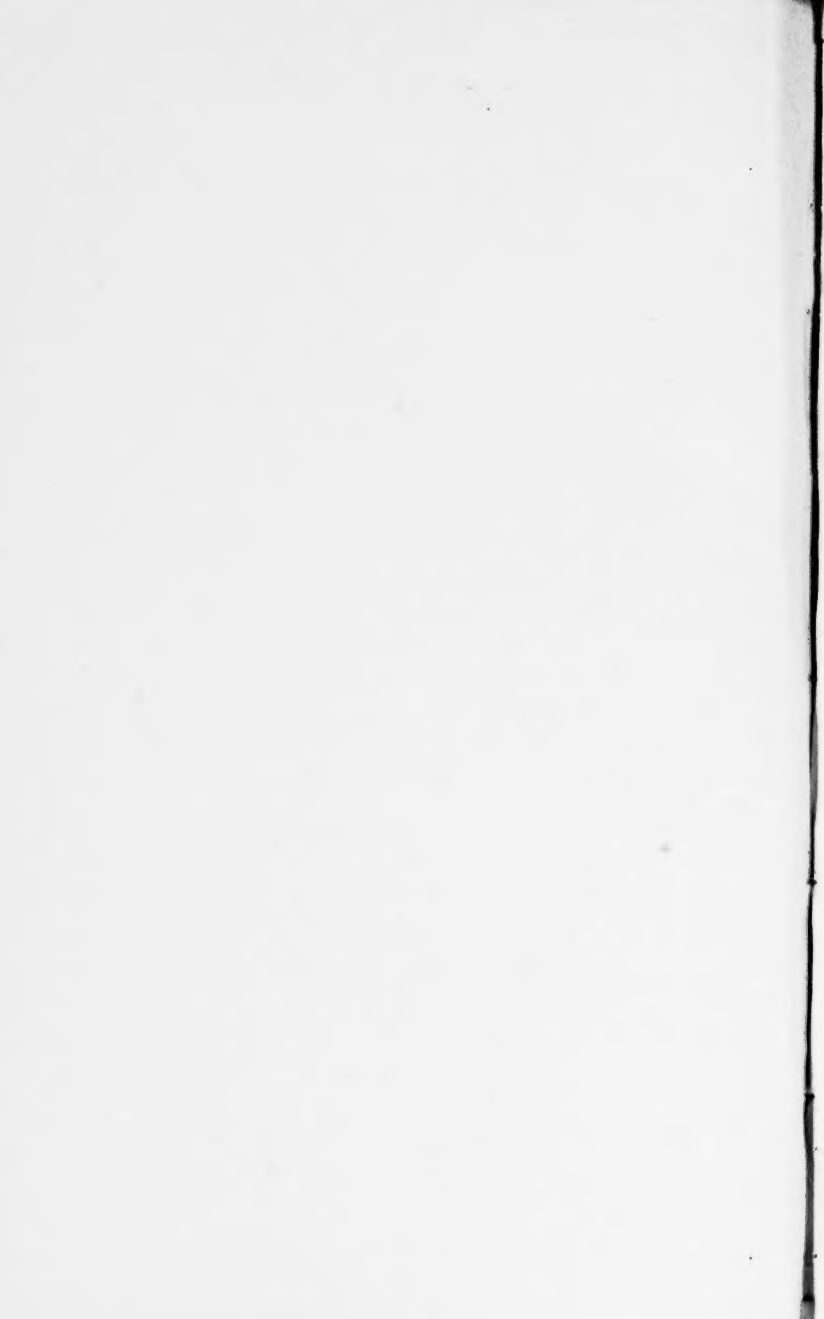
vs.

AULTMAN-MILLER COMPANY.

**ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF
APPEALS FOR THE SIXTH CIRCUIT.**

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1 United States Circuit Court of Appeals for the Sixth Circuit.

MCCORMICK HARVESTING MACHINE
COMPANY

vs.

C. AULTMAN & COMPANY *et al.*MCCORMICK HARVESTING MACHINE
COMPANY

vs.

AULTMAN-MILLER COMPANY.

Nos. 171, 172. Appeals from
the Circuit Court of the
United States for the East-
ern Division of the North-
ern District of Ohio.

The above-entitled causes were heard as one case in the circuit court and in this court of appeals. They were actions in equity to restrain the infringement of United States patent No. 159,506, for an automatic grain twine binder issued to Marquis L. Gorham on February 9th, 1875, and for an assessment of damages. The infringement charged against defendants embraced only the 3rd, 10th, 11th, 25th and 26th claims of the patent. Upon full consideration of the evidence and argument, this court is of opinion that the defendant's device does not infringe the 25th and 26th claims, and so decides. The court is also of the opinion after full consideration of the evidence and arguments that the 3rd, 10th and 11th claims of the Gorham patent are valid claims, and that they are all infringed by the defendants' machines, unless the proceedings in the Patent Office on an application for a reissue invalidate these claims.

In 1881, Helen M. Gorham, the executrix of Marquis L. Gorham, the patentee, filed an application for a reissue of this patent, in which she sought to have allowed in a reissue many new claims and many of the claims of the original patent, including the 3rd, 10th and 11th claims thereof. The application was pending in the department for nearly two years. The primary examiner held that some of the old and some of the new claims should be allowed, but by a reference to former patents he rejected among others the 3rd, 10th and 11th claims (those here in controversy) for want of patentable novelty. After this action, and without taking an appeal, the attorneys for the complainant, who had then acquired the patent by assignment from Mrs. Gorham, filed with the Commissioner of Patents upon Sept. 21st, 1882, the following written request:

"The above application (*i. e.*, for reissue of the Gorham patent) having been refused, we request that the original patent may be returned to us in accordance with the provisions of the law."

The patent was accordingly returned to complainant. This court does not find anything in these proceedings on the part of the applicant which, regarded merely as evidence or by way of estoppel, should limit or narrow the construction of the 3rd, 10th, and 11th claims. Nor does it find that the action of complainant, in withdrawing the application and patent, was taken with an intention to abandon its right under the patent as originally issued. The members of the court are in doubt, however, in view of the language of

Mr. Justice Bradley at the close of the opinion in *Peck vs. Collins*, 103 U. S., 660-665, whether or not the action of the primary examiner in refusing an allowance of the 3rd, 10th, and 11th claims of the old patent in a proposed reissue is an adjudication, binding upon the patentee and his representatives and assigns, that the claims thus rejected are invalid in the old patent. The point is important to patentees seeking reissues, and upon its decision turns the validity of an otherwise valuable and meritorious patent in this cause. Upon the foregoing statement of fact, therefore, it is ordered that the following question be certified to the supreme court for its instructions:

If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the primary examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?

It is ordered that the clerk of this court attach to this certificate a copy of the opinion of this court in these causes.

It is further ordered that all proceedings in this cause be stayed until the instructions of the Supreme Court upon the foregoing question be certified to this court.

WM. H. TAFT,
HORACE H. LURTON,
H. F. SEVERENS,

Judges of the U. S. Circuit Court of Appeals for the Sixth Circuit.

February 5, 1896.

3 United States Circuit Court of Appeals for the Sixth Circuit,
October Term, 1894.

MCCORMICK HARVESTING MACHINE)
COMPANY

vs.

C. AULTMAN & COMPANY *et al.*

MCCORMICK HARVESTING MACHINE)
COMPANY

vs.

AULTMAN-MILLER COMPANY *et al.*

Nos. 171 and 172. Appeals
from the Circuit Court of
the United States for the
Western Division of the
Northern District of Ohio.

Submitted May 22, 1894; decided July 2, 1895.

Before Taft and Lurton, circuit judges, and Severens, district judge.

TAFT, circuit judge, delivered the opinion of the court:

These are appeals from decrees dismissing two bills brought to restrain the future infringement of two patents, and to recover damages for past infringements.

The complainant, The McCormick Harvesting Machine Company, is the owner of patent No. 159,506 for an automatic grain twine binder, issued to Marquis L. Gorham, February 9th, 1875, and of patent No. 10106 for an improvement in twine binders, re-

issued May 9th, 1892, to W. R. Baker. The defendant in one action was C. Aultman & Company, and in the other was Aultman, Miller & Co. As there was a close business relation between these two defendant corporations, the actions were, by agreement of counsel, treated as one suit and heard as one cause.

The court below dismissed the bill as to the Gorham patent, first, because the assistant examiners of the Patent Office had refused to allow the claims of the old patent, here alleged to be infringed, on an application for a reissue of the patent made by Gorham's executrix in 1881, whereupon the application was withdrawn, and the old patent was returned to the patentee; and second, because in view of the prior art, the language of the claims involved must have a construction so limited as not to embrace the defendants' machines.

The bill, so far as it sought relief from infringements of the Baker patent, was dismissed on the ground that the patent was invalid for want of novelty and invention.

In the discussion of the Gorham patent and its infringement, for a reason which will become obvious, we shall first consider the second ground upon which the conclusion of the circuit court rested, namely, that even if the application for a reissue be disregarded as an estoppel, the machines of the defendants do not infringe the claims of the Gorham patent.

The object of the Gorham invention was stated in his specification as follows: "The object of this invention is to produce a machine for binding grain, that will automatically receive the cut grain from the harvester, determine the size of the gavels or bundles, perfectly and securely tie the bundles, and when so tied, discharge them from the machine without any interference or agency other than the machinery that operates it."

In 1874 when Gorham filed his application, there had been upwards of two hundred devices patented which had the object thus stated, but not one had successfully accomplished it in a practical way in the harvest field. There were two or more machines, patents for which had been taken out at an earlier date, which bound bundles of varying sizes automatically with wire, but they were wholly useless for twine because of the great tension upon the binding cord necessarily involved in the principle of their operation. The disadvantages connected with the use of the wire as the binding material hardly need to be stated because so obvious, and were shown with emphasis by the fact that until automatic twine binders were invented, nearly all binding was done by hand, and when automatic twine binding became practicable, the few wire binders went entirely out of use.

Grain, as it is cut by the knives of the harvester, usually falls on a platform moving at right angles to the direction of the horses and master wheel, and after it crosses the space behind the knives is

automatically elevated over the master wheel by endless apron or otherwise, and is thence discharged downward onto a binding table. Until a practicable automatic twine binder was made, the binding was done by hand. In many cases, the binders rode on the harvester, taking the gavel from the binding table and binding it there. In other cases, what was called a hand binder, was used. In using this, an operative adjusted the gavel for the machine, then actuated it by his hand, and this bound the bundle. The great aim of all inventors was to produce a machine which should automatically form the gavels, bind them with twine, and should discharge them thus bound by the same power which pulled the harvester, cut the grain, elevated it and cast it on the binding table, to wit, the horses. The difficulties to be overcome in reaching this result were principally in the condition of the grain as it was delivered up the elevator of the harvester onto the table. It was rarely, if ever, presented to the binder with the stalks regularly arranged in parallel lines. The heads, waists and butts seldom reached the gavel-forming and binding mechanism at the same time. The stalks were so intermingled often as to form a tangled web. The diameter of a gavel cut off from the mass by a separator cleaving down through it the entire length of the stalks at right angles to its line of movement, would vary greatly at the heads, butts and waists, and therefore any automatic devices which, in forming and sizing the bundles, acted on the butts, waists and heads at the same time, failed to produce bundles of the same size at the waist where the binding was to be done, and where uniformity in size was essential to secure a proper operation of the binding mechanism if twine was used.

Having said so much about the problem which Gorham sought to solve, we come to his machine, a vertical sectional view of which is given on page four in figure 5 of the drawings of his patent.

(Here follows diagram marked page 6.)

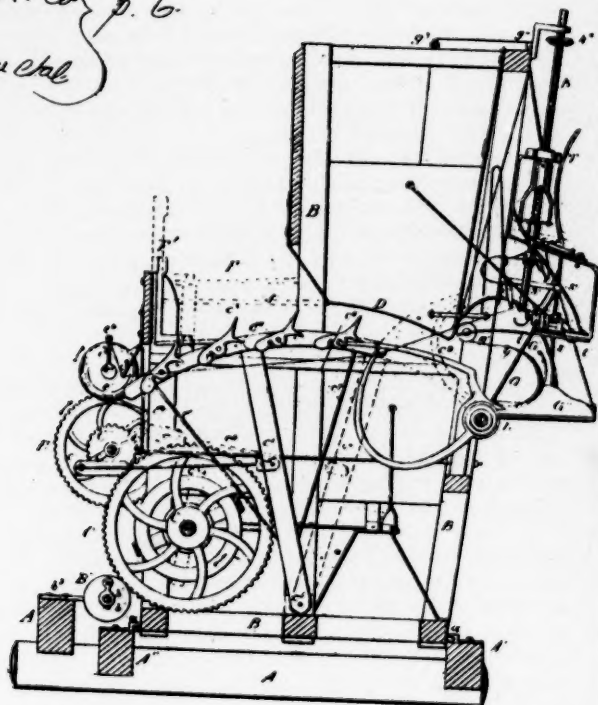
7 The Gorham binder is supported on the longitudinal sills of the harvester which are extended for the purpose, so that the grain receptacle of the binder is brought into position to receive the grain as discharged from the harvester elevator. It is supported on ways with an adjusting lever, by which it can be slid backward and forward, by the hand of the driver, for the purpose of bringing the packing and tying mechanism into such a position with respect to the elevator of the harvester that the grain shall be received by this mechanism at the proper distance from the butts and heads of the grain, whether the grain be long or short. The grain is first delivered from the elevator of the harvester into a trough-shaped receptacle (F, in the drawing) lying beneath and forming the front of the binder. In the bottom of this receptacle are two curved ribs, on to which the grain drops. Between the ribs lie two segments of a circle, designated in the drawings as C⁴, each of which is mounted on arms pivoted at their lower end to the frame of the binder. In front of the machine, and beneath the receptacle above described, is an

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Fig 5



iron shaft extending the entire width of the machine, with two cranks on the shaft set 180 degrees apart. Each of these cranks is connected by a pitman with the arm of one of the segments. When the shaft is revolved, as it is by a gear connection with the master wheel of the harvester, the two segments are forced to reciprocate in opposite directions, one advancing while the other is retreating. Each segment is provided with teeth, marked c^6 on the drawing, which are pivoted upon it near their centers in such manner that the point or acting part of the teeth will catch against the grain which is dropped upon the curved ribs when the teeth are moving from the front toward the rear of the binder, and will drop down and not disturb the grain when they are moving from the rear to the front of the binder. The result of the movement of the shaft is that the teeth on one of the segments are going forward while those on the other are retreating, and their operation is to seize wisps of grain and force them toward the rear of the machine; and this effect will continue so long as the shaft revolves and any grain is lying upon the curved ribs. At the back of the receptacle above described into which the grain flows from the elevator of the harvester and immediately over the path of the teeth-bearing segments are two flat strips of iron, described in the specifications and drawings as the guides D, secured at each end to upper cross-bars of the binder frame. These guides D extend in a curved line parallel and concentric with the line of the ribs and segments beneath to what is called the binding or bundle receptacle G of the machine. The wisps of grain seized by the teeth pivoted on the segments are carried into the throat or passageway formed by these guides D and the ribs and segments beneath, and are pressed through the throat into the bundle receptacle. This receptacle is nearly circular in form, being formed, on one side, of a curved end of a piece, C^9 , extending from between the ribs toward the receptacle G, and on the side opposite, of a flexible strap, g , with a stiff metal curved piece, G' , immediately behind it. The strap at its upper end is attached to a cord, g' , which by a system of pulleys passes up over the machine and is secured to the upper end of an arm called the trip-lever. The trip-lever is held in position by a coiled spring so that the flexible strap takes an upright or nearly an upright position against the incoming grain and is held there by the yielding pressure of the spring until the force of the grain against the strap as it is pressed rearwards by the segment teeth overcomes the tension of the spring and trips the lever. Thereby a clutch is operated and the binding mechanism proper is thrown into gear with the master wheel of the harvester. The binding mechanism consists first of the needle or cord bearing arm working on a rock-shaft beneath and in front of the binding receptacle. The needle is a curved arm of sickle shape, one end secured to the rock-shaft L and the other having an eye in it and a grooved path back of the eye in which lies the cord which it carries. The point or eye of the needle when not in operation is just below the two ribs and the two teeth-bearing segments and between them. When the needle or binding arm is set in motion, it pierces the grain moving in the throat above described and passes

through the slot between the two strips of iron called the guides D which form the roof of the throat and which strip the point of the needle of any grain which may adhere thereto. The point of the binding arm passes rearward over the binding receptacle, registers with a knotting bill which forms another important part of the binding mechanism, deposits the cord which it carries upon this bill and fastens it in a cord-holder located just beyond the bill in the path of its movement. The rearward movement of the needle carries its sickle-shaped arm across the mouth of the binding receptacle and compresses the grain therein contained against the stiff resisting arm G' forming the back of that receptacle.

The cord with which the grain is to be bound extends from a reel suspended on the front part of the binder through the eye of the needle or binding arm across the binding receptacle to the cord-holder beyond the knotting bill above referred to, so that the grain as it is forced into the binding receptacle by the segment teeth lies on the cord and the movement of the needle upward through the grain carries the cord completely around the grain which is to be bound in the bundle receptacle and back again to the knotting bill and cord-holder where the knot is tied. By a system of cams on the knotting bill shaft and otherwise, the movement of the various parts of the binding mechanism are so timed that after the powerful compression by the binding arm of the gavel or bundle, the slack of the cord thus caused is used to make the knot, and then an arm actuated by the revolution of the knotter shaft and carrying a knife and a stripping device cuts the cord and strips it from the knotting bill. Immediately two clutches securing the floor of the platform

upon which rests the back part of the binding receptacle, 9 to the machine, are released, the binding receptacle opens outward at the bottom swinging on a shaft above it to which it is hinged. Two bent arms or fingers attached to the platform on each side of the binding receptacle by the swinging of the platform strike downward against the bundle hanging in the opening thus made and throw it to the ground. The motion imparted to the binding mechanism continues by the same system of cams and returns the floor of the platform to its former place, the clutches resuming their hold while the needle arm swings back to its place beneath and between the ribs and the teeth of the segments with the cord again extending through the needle eye to the knotting bill and the cord-holder and lying as before in the bundle receptacle so that the grain is again packed over it therein. To prevent the teeth of the segments from continuing to thrust the inflowing grain forward in the throat after the needle rises and the binding begins, a cut-off F' is provided which lifts all the grain not embraced within the sweep of the rising binding arm out of the range of attack by the segment teeth. It consists of a vertically moving rack suspended in the primary receptacle F where the grain flows in from the harvester. The iron rods forming the rack are made parallel with each other and with the line of the ribs and segments and are opened toward the needle arm and when the rack is in its usual position rest on the floor of the primary receptacle below the

ribs and segments, but when it is lifted, the rods, as they rise, take up the grain from off the ribs and hold it suspended out of reach of the teeth of the segments. After the platform has risen, the segment teeth carry all the grain that remains on the ribs between the needle and the binding receptacle into the latter and thus clear the ribs. This effects the complete separation of the gavel or bundle to be bound from the unbound grain flowing into the primary receptacle from the harvester elevator. When the needle returns to its place beneath the throat between the two receptacles, the gear connection by which the cut-off was elevated is detached and the cut-off falls of its own weight, bringing the grain which has accumulated on it during the binding operation within the reach of the teeth of the segments and the operation of seizing the grain wisp by wisp, compressing it in the throat and forwarding it to and packing it in the binding receptacle proper is resumed. The binding mechanism of Gorham's binder is set in motion by the pressure of the grain in the binding receptacle against the flexible strap. This pressure is at the waist of the bundle and is necessarily in direct ratio to the size of the waist, the pressing and packing force of the segment teeth being substantially uniform. From the time the grain is delivered from the harvester elevator with the center of its stalks opposite the tying mechanism until the bundle is bound, the entire power of the master wheel of the machine is applied at the middle of the grain stalks and only there, to secure compactness and uniformity of size in the waist of the forming bundle. The steps are three. First the segment teeth separate

10 rate the tangled grain into the wisps which are snatched at their middle from the mass. Second the teeth reunite these wisps at their middle by forcing them through the throat formed by the segments and the guides D and into the bundle receptacle against the strap *g*, where the forming waist overcomes the spring and trips the lever. Third and finally the binding arm compresses the bundle at its waist against the sturdy resistant *G'* just before the knot is tied. The result of this treatment of the grain is that the bundles are always of the same size at the waist whether the grain being cut is thin or thick, short or tall. There is little if any tension of the binding cord in forming or compressing the bundle.

It is strenuously objected that none of the functions, except that of conveying, which we have attributed to the segmental teeth and the guides D are performed by them and that Gorham did not intend they should be. It is true that Gorham does not describe the wisp-by-wisp-seizing function of the segmental teeth and he does not allude specifically to the fact that the guides D would compress the wisps of grain as they were forced forward through the throat into the binding receptacle at their waist and thus effect an initial or preliminary compression. The court below held that in the mind of the inventor and in fact the segmental teeth were only conveyers and had no function to perform in connection with the packing of the grain at its waist. We cannot concur in this view nor do we think that the patentee in his specifications limits himself to this one function.

The specifications describe the operation *is* as follows: "The binding cord being in place, by passing it from the spool through the guides, over the cord-carrier, and through its eye over and beyond the hook of the knot-tier to the cord-holder, and there securely held, the binder adjusted properly upon the frame of the harvester to deliver the grain centrally with the line of the knot-tying device, the machine is put in motion by the forward movement of the harvester. The cut grain flows into the receptacle of the binder, and is fed toward the bundle receptacle by the movement of the feed-dogs and against the curved holder binding cord, and adjustable binding strap which, when the unbound grain is pressed against the strap sufficiently, causes the trip-lever to which it is attached to move and allow the other parts of the device to operate. As the movement of other parts is now effected, a vertically working rack in the receptacle is raised, which holds back the inflowing grain, while that which has passed off the rack is advanced by the feed-dogs, to make a clear open space behind it, so that the cord-carrier can grasp it and compress it in the binding receptacle while the knot is tied on the cord that surrounds it. * * * The feed-dogs force the grain from the point where the long central finger of the rack parted the grain forward of and beyond the end of the cord-carrier, opening a space through which the cord-carrier and cord safely pass without obstruction by the straw."

11 It seems to us manifest from this language and the necessary operation of the machine that Gorham intended that his feed-dogs should discharge not only the function of conveying the grain but also that of packing it under the guides and into the binding receptacle. Their movement reached quite beyond the head of the needle and down toward the receptacle. No other means for creating the pressure against the triggering resistant is shown or suggested. It is not stated that the grain is compressed against the guides D, but their form and direction makes it a necessary result of the mechanism described.

The same thing is true of the wisp-by-wisp-snatching function of the segmental teeth. The evidence *satisfactorily* shows that this is, and must be the operation of these teeth.

It is not material that Gorham did not describe in full all the beneficial functions to be performed by the parts of his machine, if those functions are evident in the practical operation thereof and are seen to contribute to the success of his device. *Eames vs. Andrews*, 122 U. S. 40. It is difficult to believe that a man of Gorham's inventive genius did not perceive the useful functions which the parts of his machine so well performed, even though he did not specifically mention them all.

An argument is made by counsel for the appellees that there is nothing in the Gorham patent which would prevent an infringement of that patent by the use of three conveyers with toothed segments. Whether such a device would be operative, and if operative would be an infringement of the Gorham device, is entirely aside from the point. The machine described by Gorham in his patents is a machine in which the conveying, the packing, the compressing

and wisp-snatching are all done at the waist of the bundle as well as the binding, and it is the size and pressure at the waist of the bundle which determines the time of the tripping. It is a plainly unsound argument to say that because Gorham does not expressly limit his patent to the device which he actually shows with only one system of conveyers, packers and compressers at the waist of the bundle, therefore he is not entitled to the benefit of the invention involved in the use of one. The whole structure of the patent with the manifest principle of its successful operation excludes the possibility that Gorham did not rely on the waist compression and treatment of the grain as a main feature of his patent.

As already stated the prior art before the Gorham invention embraced some 200 patents for the automatic binding of grain. In this large number of patents, the Gorham patent was the first which successfully bound grain with twine in the field. It is vigorously contended, however, that in this very extensive history of the art, there was much so suggestive of Gorham's forms that he is entitled to nothing but a literal construction of his claims. For the purpose of fully considering the weight of this argument, we propose now to examine those forms in the prior art which are relied on as anticipations or suggestions of the parts of Gorham's machine.

The first patent relied upon as an anticipation of the *the* segmental teeth is the Glover patent of 1858. It was a machine for conveying or elevating grain.

It consisted of a frame within which were arranged three pairs or more of toothed parallel bars so connected to two crank shafts that when the shafts were revolved they gave to the bars in each series an alternating vertical and longitudinal motion which carried the grain resting on the bars in the direction of the rotation of the shafts. The bars were bent upward at one end beyond the second crank shaft so as to elevate the grain, and to prevent the slipping back and entangling of the grain, as it was being elevated, a shield was suspended by a spring over the elevating part of the bars and parallel to the upward movement of the grain. The shield held the grain to the spikes of the bars, as it was carried up, but when it was necessary to avoid choking, it yielded and allowed the excess to pass through. The shield was curved outward at the lower end to allow the grain to pass under it.

The Jones and Low & Adams patents were very similar to the Glover patent. They each had three pairs of alternating bars with teeth. In the Jones patent a covering to the elevating bar was provided quite like the shield of Glover. Instead of a shield, Low & Adams provided what are called grates, secured to the frame by springs and pressing the grain to the teeth. In these devices also the grain was delivered to the binding table to be bound by hand. The Whitney patent was for the same purpose, but was somewhat differently arranged. The bars were in three pairs or series, but the crank shaft was used to give them a reciprocating sliding motion forward and back, but no vertical motion. Teeth were pivoted to them, so that when the bars were sliding forward they would catch

the grain and push it on, but when retreating the teeth would be lowered and would pass under the grain. Many other forms of grain elevators are shown in the prior art, some with endless belts with spikes in them, and others with two endless canvas aprons with cleats athwart them, working in the same direction and carrying the grain between them, but none of them is as much like Gorham's toothed segments as those already mentioned.

None of these patents can, it seems to us, narrow the scope of the invention of Gorham in the use of his toothed segments of his organization. The prior devices were merely for elevating and conveying the grain. They neither effected nor were intended to effect the compression of the bundle at the waist, and the pressing and packing of the same against a triggering resistant. They effected no wisp-by-wisp separation, for this is impracticable in any device which attacks the tangled mass of cut grain at both ends and the middle. Manifestly a snatching at the tangled mass of irregularly

deposited grain at the same time at the heads, butts, and waist
13 would pull the whole as a mass rather than separate wisps therefrom. Gorham's toothed segments undoubtedly had a conveying function and to this extent, these prior devices suggested his different form, but the segments with the guides D also had the waist-separating and packing functions, which were absent in the prior art. The shield of the Glover device and the grate of Low & Adams had some apparent likeness to the guides D of the Gorham patent, but in function there was but little resemblance. In the two prior patents, these coverings of the conveying devices were spring-yielding, and were used to hold the grain to the straight teeth of the conveying bars on the inclined plane up which they elevated the grain. They were made with springs for the express purpose of allowing choking masses of grain of unequal size to pass up from the harvester platform. They were not intended to compress the grain into a narrow throat with a view to uniformity of size at its waist, and they did not in fact accomplish this result. The guides D have two functions. They form the rigid roof of the compression throat to co-operate with the packing function of the segment teeth, and they strip the needle arm of adhering grain as it passes between them on its way to the knotting bill and cordholder. Neither of these functions is performed by the shield of the Glover patent or the grate of the Low & Adams.

It is said that it involved nothing but mechanical skill to reduce the three pairs of conveying bars to one, and that this being done in the old patents, Gorham's device would be shown. This is a palpably fallacious argument. The invention consisted not in devising means for effecting the wisp-by-wisp attack and compression at the waist, the advantage of these steps being known, but in hitting upon a machine which for the first time showed that advantage and made it clear that such an attack and compression would give an important initial step in the formation of a bundle which should be uniform in size at the point where uniformity alone was needed. After Gorham had shown by the successful operation of his machine this mode of properly preparing a bundle, it then became a matter

of mechanical skill, or it may be tributary invention, to discover in the prior art, other conveying devices which when applied only at the waist of the bundle, would effect the same wisp-by-wisp separation and packing in even a more satisfactory way than that of Gorham.

Reference was made by defendant's experts and the court below to certain prior patents for automatic binders which were supposed to limit the scope of Gorham's invention, and some consideration must be given to them. The first is that of Watson and Renwick, patented in 1853. In this, the grain was carried from the harvester platform by two endless aprons and deposited on an elevated platform, whence it slid down freely and uncompressed into the receptacle, semi-cylindrical in form, where it was compressed and bound.

The compression was effected by the lowering upon the grain
14 lying loosely in this receptacle of a semi-cylindrical frame of inverted crutches, which squeezed the bundle from end to end. The cut-off was swung across the grain passage, and the size of the bundle was determined by a certain number of revolutions of the master wheel of the harvester. The machine was not operative, and certainly embraced none of the essential features of Gorham's bundle forming, sizing, and compressing mechanism.

In the McPhetridge patent, which was a wire binder, the grain was delivered by four endless belts upon the binding wire stretched across the orifice of a receptacle. The weight of the grain caused the wire to belly down into the receptacle. At intervals of time measured by the revolutions of the master wheel, a binding arm closed about the gavel suspended in the wire, knotting or twisting the wire and cutting it. In this patent, the grain accumulating after the binding arm had crossed the mouth of the bundle receptacle, was cut off by a segmental offset from the back of the arm, which is almost literally reproduced in defendants' machine as a substitute for Gorham's cut-off rack. It is evident that here we have not a single feature of the binding and compressing devices of Gorham. Such compression as there is in McPhetridge's device is effected by the wire, and this is manifestly entirely unadapted to a twine binder where the tension must be slight or the cord will break.

In the Carpenter patent, which is a wire binder, the same thing is true. In that, the grain is elevated by two endless aprons to a point above the binding mechanism, whence it is carried down by one of the aprons under a series of loosely swinging rollers arranged to keep the grain from becoming entangled in the binding mechanism and to straighten it, into a cradle where it lies unconfined, and is taken up by a revolving rake, which sweeps it into a passageway against the binding wire. The passageway is formed on one side by two or more compressor rods, which yield and open as the rakes sweep the gavel against the wire and press it onto the point where the binding arm actuated at regular intervals measured by the revolutions of the master wheel, embraces the bundle with the wire and knots and cuts it. There is no wisp-by-wisp separation and packing of the grain at the waist in this device. The wire itself is used

to effect the waist formation, and no twine could stand the tension thus made necessary. There is no self-sizing of the bundle at the waist or elsewhere. The action of the rake is on the whole length of the bundle, and all the peculiarly Gorham features are absent.

A patent for bundling kindling wood is also relied upon as showing an anticipation of some of the elements of Gorham's patent. In it the wood is carried by two endless belts onto a series of curved plates pivoted one above the other in a circular opening corresponding in size and opposite to a so-called bundling tube. As the wood is delivered, the curved plates yield by its weight until the opening is

15 full and the plates are bent back against the periphery of the opening, where a lever is tripped and mechanism is set in operation, which forces a plunger endwise against the wood secured in the opening, carrying the wood into a tube where it is subsequently bound. This device does suggest the use of the weight of the material to be bound to spring a lever and to set binding or other mechanism in motion, but it has no relation to Gorham's device, and certainly has no bearing upon his mode of forming and compressing the waist of his bundle.

Another patent referred to by the court below and alluded to for various purposes by defendants' experts is the Gordon binder. This is a wire binder in which the grain is carried up an elevator and through a curved passageway into an open receptacle, where it first falls or slides onto a series of bars called gavellers, revolving on a shaft, which are actuated at regular intervals, and so deposit the grain on them, and turning round are ready to receive another gavel. The gavel deposited falls on the binding wire stretched across below it, and is bound by the swinging across of a binding arm. Some pressure is effected between the binding arm and a reciprocating arm, and a cord between them, which is supposed to relieve some of the tension on the wire, but it is obvious that the original compression is almost wholly by the wire, and that this device could not be used as a twine binder. Moreover, the wisp-by-wisp action, the preliminary packing at the waist by the toothed segments and the guides D, and against the triggering resistant, are none of them found here. It is sought to make the gullet of the Gordon patent operating in conjunction with the Gordon pickers an anticipation of the toothed segments and the guides D in the Gorham patent, or at least a justification of the use by the defendants of their pickers and their breast. The complete answer to this claim is that the roof of the grain passage in the Gordon patent was only as a means of holding the grain to the pickers as the pickers cleared the grain from the passage. Neither the pickers nor the roof had any effect to pack the grain, nor were they intended to do so. The roof extended from one end of the grain to the other as the pickers operated on the waist, the butts, and the head, and the effect of their co-operation was merely to throw the loose grain out of the mouth of the grain passage into a loose heap on the surface of one of the gavellers below it. They had nothing to do with the formation of the bundle or its compression at its waist.

Finally we come to the Spaulding patent of 1870, upon which the

defendants have most relied as anticipating and suggesting much in Gorham's patent. The Spaulding device was for a wire binder. It had an endless apron with cleats to convey the grain as it fell from the knives to the foot of a vertical elevator apron with straight teeth. Opposite the elevator apron was a swinging board or flap to hold the grain to the teeth. At the top of the passageway between the flap and the elevator apron was a curved hood of thin metal mounted on the shaft from which the flap swung. Its other end rested on the so called binding table at the head of the grain passage. Three slots in this hood, one at each end and one in the middle, afforded to two discharging arms and a binding arm in the middle an opportunity to swing from a position of rest on the rock-shaft of the hood across the passageway to the surface of the binding table opposite. The proposed action of the machine was this: the grain was to be elevated into the receptacle above the elevator passage by the elevator apron against the binding wire stretched across the passage from the end of the binding arm on the rock-shaft of the hood to the twisting and cutting device on the other side. The grain was to press up against this wire and under the hood until the hood should be lifted and the rock-shaft turned. The turning of the rock-shaft by a system of levers set in motion the mechanism holding and supporting the binding arm and the discharging arms and swept them across the grain passage and through the flow of the upcoming grain, forming a gavel and enclosing it in the wire which the binding arm carried to the twisting and cutting device, and then sweeping the gavel on off the table. A counter-weight is shown in the patent intended to lift the shaft, which carries the discharge and binding arms, after the bundle is swept off, up above the grain accumulating in the hood behind them, and to restore them to their place of rest on the rock-shaft of the hood, ready to begin the binding and sweeping of another gavel. This device was claimed by the patentee to self-size every bundle with exact uniformity, and properly to bind and discharge it. In the first place the machine suggested by the patent was a wire binder and the use of the cord to compress the bundle at the waist would be quite out of the question in a twine binder. In the next place the binding mechanism is conceded to have been wholly inoperative. The defendants were given full opportunity to show an operative machine for binding, and did not even attempt it. It appears further in evidence that the Spaulding machine never bound a bundle. It was an abandoned experiment. This is most clearly shown by the fact that thereafter Spaulding took out one or more patents for devices for hand binding. But, while this is hardly denied, it is said that the Spaulding patent suggested the possibility of self-sizing uniform bundles by pressure against a triggering resistant, and that the device of Spaulding was operative to the extent at least of such self-sizing. After a careful examination of the Spaulding patent, we are convinced that the only suggestion contained in the Spaulding patent was the possibility that by some future invention the increasing size of an incipient bundle might be used to effect a proportionate pressure upon a trigger or trip-

lever, so that when the gavel was of a certain size the pressure would increase to the point of tripping the lever and operating other mechanism, till then at rest. How this possibility could be really made valuable and practicable, the Spaulding patent does not show. The means provided in it for its avowed object were wholly inadequate. It is demonstrable that the vertical elevator

17 provided in the patent will not elevate the grain to the binding table unless the flap which is loose is changed in form so that it flares at its lower end, and is there secured by spring connection with the frame of the machine. Unless the teeth or spikes which are shown as straight in the drawings are bent downwards, the elevating apron will carry the grain around the upper roller and down on the other side. If the teeth are bent back, then the elevating power of the apron is so much reduced that it cannot force the grain upwards against the wire stretched across the passage so as to overcome the tension which the wire must have to make the mechanism operative. But, even suppose that the grain is forced against the wire with sufficient force to belly the wire and assume an incipient bundle form, the irregular mode in which the cut grain will reach the hooded chamber from the elevator apron (as to which all the witnesses agree) sometimes heads first, sometimes butts first, and never waist first, because of the resistance of the wire at the waist, will lift the hood now at one interval and then at another, and never with any uniform relation to the size of the bundle at the waist where it is to be bound. The experiments of the defendants to show the utility and operativeness of the Spaulding patent were limited to elevating straw on a different elevator from that shown in his patent into a chamber without the wire across its entrance made necessary by his patent, onto a table differently constructed from that in his patent as to the angle of its plane. When the hood was lifted by the grain thus accumulated, and its rock-shaft actuated a series of levers which swept three arms from the rock-shaft across to the binding table through the slots in the hood, this was said to show the practical character of the Spaulding patent. The arms would not even sweep the dry straw from the table and the machine became completely choked unless the operator took out each gavel with his fingers after the arms had swung onto the so-called binding table. All that the experiment demonstrated was that if one could force grain enough under a hood mounted on a rock-shaft which would yield on slight pressure, one could thereby trip a lever attached to the rock-shaft and set in motion any desired mechanism properly arranged for actuation by the tripping of the lever. The Spaulding patent showed nothing more of value to Gorham than this, if indeed it can be said to have furnished to him the practical means for illustrating even this not very complicated mechanical phenomenon. There was nothing in the Spaulding patent which showed the treatment of the bundle at the waist by segment teeth and the guides D or their equivalent or by compression at the waist in a receptacle like that of Gorham.

The tripping feature alone is present in both, but its use is so different in mode and result in the sizing of the bundle and its

binding, that the suggestion of the feature by Spaulding to Gorham was very remote from Gorham's application of it. It is said that it would take no mechanical skill to reduce Spaulding's hood to the width of a single narrow arm operated on by the waist of the gavel, and as little to reduce the teeth on the elevator apron to a single line or belt. Thus changed the Spaulding machine would not do Gorham's work and would be inoperative as a binder. But concede that it would, still the change involved the highest order of invention. It would not involve invention if one knew what Gorham first showed the world, namely, that the only successful twine binder was one which from the reception of the grain from the harvester to its deposit in a tied bundle would apply all available power to the preliminary and final forming and compressing of the waist of the bundle and should use such waist in its progressive growth as the measure of the alternations of the necessary intermittent mechanism.

The complainant company is the owner of the Spaulding patent with a great many others in the same art. Some time before bringing this suit, it made an arrangement with the owners of other patents by which all were conveyed to a trustee to issue licenses to others for the use of all their patents. In some of these licenses, the Spaulding patent was included as one of a number and it is now argued that the complainant company cannot be heard to deny the operativeness of the Spaulding patent. As the defendants were not among complainant's licensees, no estoppel arises in this suit and the fact is only evidential as an admission against complainant which can be explained or rebutted. The evidence in the case as to the Spaulding patent, and its inoperative character in our view completely overcomes any inference thus sought to be drawn, while the omnibus character of the licenses including so many patents much weakens the evidential force of the otherwise natural implication of a license that the licensor asserts the operativeness of the device licensed.

Defendants' experts maintained that the Spaulding device had been shown to be operative in a binder known as the Miller binder made and sold in considerable quantities in 1881 and 1882. The description of the Miller patent showed a wide difference from the Spaulding device which was emphasized by the admission elicited from defendants' witnesses that when these machines were made, the defendants who made them had no license to use the Spaulding patent.

The Gorham binder was, as already stated, the first one in the history of the art which successfully bound grain in the field with twine automatically. There is abundant evidence to show that the binder did actual and satisfactory field work on farms in 1874, in 1875 and in later years. After 1875 Gorham made one or two changes in the machine. He dispensed with the flexible leather strap and substituted a metallic trigger or finger in its stead operating the trip lever by a rock-shaft upon which this finger was mounted instead of by the cord attached to the leather strap. He reduced the number of teeth on each segment from four to three. From 1878

19 until the present time, automatic twine binders have been in the most extensive use throughout the civilized world. They have been called the Appleby twine binder because Appleby in 1879 secured a patent on such a binder; and this binder with improvements is practically the only one now in use. The defendants manufactured the Appleby binder and the question in the case is whether the Appleby binder does not find its substantial prototype in the Gorham binder. Every manufacturer of the modern Appleby binder became a licensee of Gorham except the present defendants and after the complainant became the owner of the Gorham patent the defendants made a written contract with Mrs. Gorham, the executrix of Gorham, by which they agreed that if she would obtain a retransfer of the patent to herself, they would buy it from her and pay her therefor \$100,000.

The original Gorham binder was a heavy, crudely constructed machine and bore little superficial resemblance to the modern lightly constructed but strong and smoothly running twine binder. But an examination of its parts and their operation convince us that in it is the modern twine binder, modified only by the mechanical and economical skill of the manufacturer, and the tributary inventive faculty of a mere improver.

On the whole case, we are satisfied that the Gorham binder was a primary or pioneer patent of the highest merit, that it attained a result wholly new in a new way and that in the consideration of alleged infringements of it, the patentee is entitled to all the liberality of treatment accorded to that comparatively rare class of patents. With respect to such a patent, the well-settled rule is that the patentee who has, by the success of his patent, pointed out the combination of functions needed to reach the new result and has claimed the combination of mechanical parts performing those functions, may enjoin the use of another machine producing the same result where the second machine differs from the first only in a substitution for parts or elements in the patented device, of parts or elements which though different in form and kind perform the same functions in substantially the same way. It may be that the substituted parts are well-known equivalents of those shown in the patent for the performance of the functions to which they are respectively applied, in which case there is manifestly no inventive faculty shown in the change; or it may be that being shown by the successful operation of the patent the exact nature of the functions to be performed by a part of the patented device, the infringer by the use of his inventive faculty hits upon something as a substitute which will perform the same functions more completely and satisfactorily. In the latter case, he is a tributary inventor but he is none the less an infringer if he uses the whole machine with his substituted part to accomplish the same new result. The rule as to infringements of pioneer inventions which point the way to new products or results is analogous to that applied in cases of infringements of process patents in which the discoverer is only required to point out one practical method of using his process, and is permitted to claim tribute from all who thereafter use

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the process whether with his apparatus or with a different or improved means.

In *Morley Machine Company vs. Lancaster*, 129 U. S., 263, 323, the Supreme Court said:

"Where an invention is one of primary character and the mechanical functions performed by the machine as a whole are entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine." See also *Consolidated Valve Company vs. Crosby Valve Co.*, 113 U. S., 157; *Royer vs. Schultz Belting Company*, 135 U. S., 319; *Machine Co. vs. Murphy*, 92 U. S., 120; *Sessions vs. Romadka*, 145 U. S., 29; *Clough vs. Barker*, 106 U. S., 166; *Winans vs. Denmead*, 15 Howard, 330; *McCormick vs. Talcott*, 20 How., 402, 405; *Railway Co. vs. Sayles*, 97 U. S., 554, 556.

Having settled the character of the Gorham invention and the principle to be applied in considering infringements of it, we come next to a consideration of the essential features of the defendants' machine. In it the grain is delivered from the harvester onto what is called a binding deck or table. The table has three slots in it underneath which is the shaft extending from one side to the other of the binder. On the shaft are two cranks, 180 degrees apart, to which are attached legs carrying at their upper ends packing teeth rigidly fixed thereto. The legs are pivoted on a radius bar and the operation of the shaft is such that one packing tooth is advancing up and through one of the slots while the other is retreating down and under it and *vice versa*. While a packing tooth is advancing, it is above the surface of the table and while retreating it is below the surface. The line of its motion is that of an irregular ellipse. On each leg are two teeth; the first tooth is sharp and rises higher than the second, which is broader and bears about the same relation to the first tooth as a thumb does to the finger in an outstretched hand. Immediately over the path in which the packing teeth move is what is called a breast or rigid roof with which the packing teeth co-operate in the seizing, forwarding and compressing of the grain against a yielding finger mounted on a rock-shaft which at a certain compression of the grain sets in motion a clutch throwing the binding mechanism into gear and raising a sickle-shaped needle from its position of rest in the slot of the binding table between the two slots in which move the packing teeth. The needle as it rises, pierces the grain above it, strips it in the breast or rigid roof, passes on and carries the cord about the bundle to the knotting device and cord-holder, compresses the bundle between it and the stiff back of the binding receptacle. In some forms of the

21 machine, this stiff back is the trigger or yielding arm which having served the purpose of a trigger and thrown the clutch becomes fixed in its position and able to act as a sturdy resistant. In other forms, the trigger and sturdy resistant are two different pieces of metal. After the cord has been knotted, cut and stripped, the binding receptacle instead of swinging backwards as in the Gor-

ham machine and leaving an opening between the main body of the machine and the platform of the binding receptacle for the precipitation of the bundle, swings on a rock-shaft and hinge beneath the main frame of the binder withdrawing the finger or fingers which form the back of the receptacle out of the way of the bundle and throwing it to the ground. Instead of the cut-off rack which Gorham used, the defendant keeps the grain out of the throat or passageway after the rising of the needle by a segmental arm or curved projection on the back of the needle itself (a reproduction of the same element in the McPhetridge patent) which forms a complete barrier to the entrance of the inflowing grain to the throat or passageway while the needle and compressing arm is doing its binding and tying.

Does this machine infringe Gorham's patent?

Appleby, defendants' licensor, had long been engaged before 1874 on the problem of devising a practical automatic twine binder. In that year, he visited Gorham at Rockford, Illinois, and examined his machine while in successful operation in the field. Subsequent thereto he devised his own machine after a number of unsuccessful experiments and settled down to the form which we find in that of the defendants. His machine, as used by him in 1878, had but one packer on each leg and this is its appearance in the drawings and specifications of the patent taken out in 1879; but finding the machine to be inoperative in this form, he added the second tooth to each of the legs. These circumstances tend strongly to show that Appleby took Gorham's idea as developed in his patented and operative machine.

When we look at both machines, we can trace a close resemblance. Part for part, element for element, function for function, the Appleby machine parallels that of Gorham.

There are five claims of the Gorham patent which the complainant avers in its bill that the defendants infringe. They are the 3rd, 10th, 11th, 25th and 26th claims. The 25th and 26th claims relate to the mechanism for cutting and stripping the cord after the knot has been tied by the knoter bill and will be considered hereafter. The other claims are as follows:

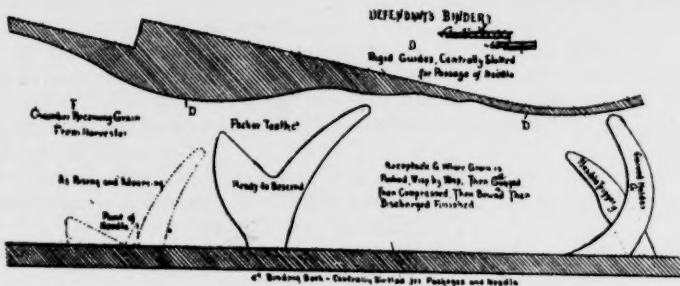
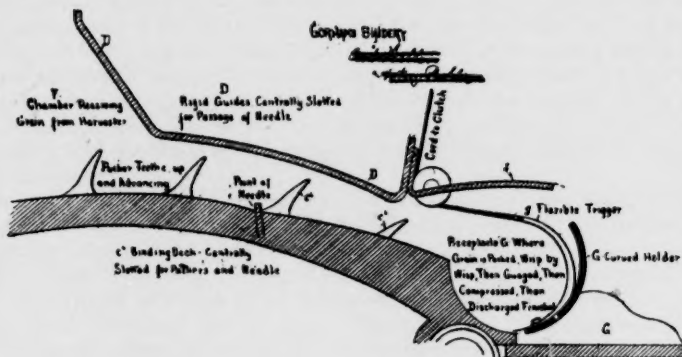
3rd. "The reciprocating segments C^4 having the feed-teeth c^6 in combination with the guides D, as and for the purposes specified."

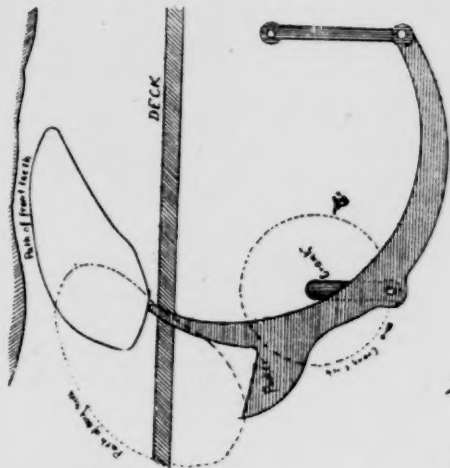
10th. "The flexible strap g , arranged in receptacle G to operate trip lever H, in the manner substantially as and for the purposes described."

11th. "The combination of the binding strap and cord g' with the bundle receptacle G and tooth-feeding segments C^4 , substantially as and for the purposes described."

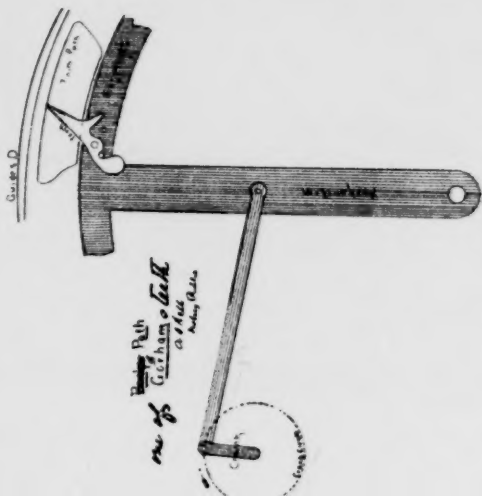
22 We cannot doubt that defendants' packers and breast infringe Gorham's third claim and are the equivalents of his segment teeth and guides D. The packing teeth have a much shorter forward and rearward movement than the segment teeth of Gorham and some other means is therefore used to bring the grain within the reach of the packing fingers after it has left the harvester. In the ordinary form of defendants' machine, this is done by inclining

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the binding deck downwards so that gravity brings the grain to the packing teeth. The packing teeth have the function of conveying the grain from the point where it reaches them to the binding receptacle. This is clearly shown by the fact that the machine will work even when the inclination of the deck is upward, instead of downward, from the harvester, provided only that the grain be delivered within reach of the back teeth of the packers. A very common form of the machine manufactured by the defendants called a low-down twine binder has its binding deck inclined upward from the harvester. The packers, it is conceded perform the wisp-by-wisp and the packing functions at the waist of the incipient bundle. They therefore discharge exactly the same functions which are discharged by the segmental feed-dogs of Gorham, in much the same way. The following drawings fairly illustrate the operation of Gorham's and defendants' teeth from the mouths of the throats formed by guides and defendants' breast to their respective binding receptacles.

(Here follow diagrams marked pp. 23 & 24.)

25 The defendants' experts trace the packing teeth of the defendant- to the packers of the Gordon patent and it is true that their operation above and beneath the plane in which the grain moves is quite like that of the defendants. Gordon's pickers never, however, were used for anything but for conveying. They were never used for packing and therefore they were never used to discharge the wisp-by-wisp function which is only important in the subsequent packing of the grain, and is only effective with one series of packers, while in the Gordon patent there were three series operating, not only at the waist, but also at the butts and heads of the grain. Given a knowledge of the peculiar and useful functions of the feed-dogs and guides D in accomplishing automatic twine binding in the Gorham mechanism, it hardly required more than mechanical skill to see in the mechanism of the prior art that the pickers of Gordon or the reciprocal bars of Jones to which the defendants' packers are also likened, could be used to perform the same function as the segmental teeth of Gorham. It is true that these were functions which Gordon's pickers and Jones' bars had never been used before to discharge, but the fact that the Whitney feed-teeth did successfully discharge those functions, at once suggested that the Gordon pickers and the Jones reciprocal bars, which were recognized mechanical substitutes for those teeth, would, if reduced to one series, operating upon the waist alone, effect the same or a similar result.

In *Morley Machine Co. vs. Lancaster*, 129 U.S., 263, already cited, Mr. Justice Blatchford said:

"It may be true that the defendant's peculiar form of stitch was unknown before; and it may also be true that his arrangement for carrying the buttons with their eyes upward and turning the eyes into a horizontal plane by the twisting of the conveyor-way was not before known. Of course, they were not before known in a machine

for automatically sewing buttons to a fabric because Morley's machine was the first to do that. But still the defendant employs for the above purposes known devices which, in mechanics, were recognized as proper substitutes for the devices used by Morley to effect the same results." * * *

"In this sense, the mechanical devices used by the defendant are known substitutes or equivalents for those employed in the Morley machine to effect the same result; and this is the proper meaning of the term 'known equivalent' in reference to a pioneer machine such as that of Morley. Otherwise a difference in the particular devices used to accomplish a particular result in such a machine would always enable a defendant to escape the charge of infringement, provided such devices were new with the defendant in such a machine, because, as no machine for accomplishing the result existed before that of the plaintiff, the particular device alleged to avoid infringement could not have existed or been known in such a machine prior to the plaintiff's invention."

We come now to the 10th and 11th claims.

26 The experts and counsel on both sides agree and we concur with them in thinking that to sustain the tenth claim which is for the flexible strap *g* arranged in receptacle *G* to operate trip-lever *H*, there must be read into it the means of pressing it into action, namely, the tooth-feeding segments, so that the tenth claim is for substantially the same parts as the eleventh claim, which is for "the combination of the binding strap and cord *g* with the bundle receptacle *G* and tooth-feeding segments *C*⁴, substantially as and for the purposes described." It seems to us that into the eleventh claim should also be read as an element the guides *D*, because the proper co-operation of the segment teeth, flexible strap and binding receptacle necessary to the result sought could hardly be secured without those guides. The combination claimed would then be:

1. The tooth-feeding segments.
2. The guides *D*.
3. The flexible strap *g*.
4. The bundle receptacle *G*.

The bundle receptacle *G* as described in Gorham's patent has as its essential parts in addition to the flexible strap:

- a. The sturdy resistant back of the strap to co-operate with the compressor arm of the cord-conveyor in the final compression.
- b. The means for discharging the bundle after it is bound and tied.

We are now to consider whether these, or substantially equivalent elements of this combination are found in the machines of the defendants for the performance of substantially the same functions in automatic twine binding. We have already seen the equivalents of the segment teeth and the guides *D* in defendants' packers and breast. We come then to the flexible strap *g*. Its function is to assist in the waist compression of the bundle as the wisps of grain are forced against it, and then upon the yielding of the spring with which the cord *g'* connects it to trip a lever and start the binding mechanism. For exactly this same purpose, the defendants use a

metal finger mounted on a rock-shaft. The leather and the metal triggers were mechanical equivalents. The transmission of the force of compression to trip the spring lever by means of the rocking of a shaft upon which the yielding resistant was stiffly mounted was a well-known substitute for a strap and pulley. The rock-shaft connection between the yielding arm and the lever actuating the binding mechanism was suggested in the Spaulding patent. Even if it involved patentable invention to substitute the one for the other, it was but tributary invention which did not prevent infringement, for the two devices discharge the same functions in substantially the same way.

Next we come to the bundle receptacle G. The space between the packers and resisting finger of the defendants corresponds in every function with the binding receptacle of Gorham. Here the grain is received, wisp by wisp, partially compressed at the waist by the packers and breast. Here it is still further compressed against the triggering resistant and by the yielding spring upon which the resistant acts, the bundle is sized at the waist. Here the cord is carried about the bundle. Here the waist of the bundle is further compressed between the compressor-arm of the cord-carrier and a sturdy resistant forming the back of the receptacle. In the same way in both machines, tension on the cord in the compression is reduced to a minimum. In some of the defendants' machines the two functions of the triggering resistant, and the sturdy compressing resistant are performed by the same metallic finger which, by means of the rocking of the shaft, and a rigid limit of its motion, at one time is made to serve the one purpose, and at another time the other. In other machines of defendants, there are two different metallic fingers, one the trigger, and the other the stiff compressor. In either case, it is quite manifest to us that however great the ingenuity shown, and the degree of usefulness attained in the change from the form of Gorham's devices, the substituted parts are but the equivalents of his in his combination—patentable improvements doubtless, but only improvements.

If in the 11th claim, by the reference to the bundle receptacle G, is also to be included the means for discharging the bound bundle, we have no difficulty in holding that the mode by which the bundle is discharged from the defendants' machine is, within the rules which apply to the infringements of a pioneer combination patent, nothing more than the mechanical equivalent of the means for accomplishing the same purpose in the Gorham device. The receptacle platform in the Gorham device swings outward and backward leaving an opening below for the bundle to fall through while the receptacle platform or its equivalent in the defendants' machine swings downward and forward out of the path and away from the bundle which without support falls to the ground.

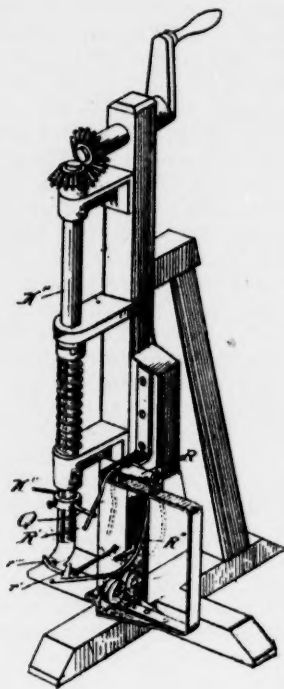
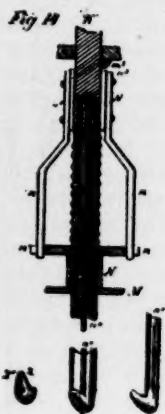
It is further pressed upon the court that the mere fact that the claims of the Gorham patent are expressed by reference to the lettered parts of the machine as shown in the drawings, must lead to a literal and formal construction of the claims and limit their scope exactly to the form of the device used and suggested by Gorham

This was the view of the learned justice who delivered the opinion in the court below, and he cited the cases of *Wier vs. Morden*, 125 U. S., 106, and *Hendy vs. Miner's Iron Works*, 127 U. S., 375, in support of his conclusion. We are unable to concur in this application of those cases. They did not involve pioneer or even meritorious patents.

They were for devices which were at the best mere improvements on previous well-known devices and no matter what the claims had been, they would have been limited to the particular forms therein described. In the latter case, the court found that there was no invention or patentability in the elements claimed and as an additional reason for holding the patent invalid, suggested that the element claimed was linked in combination with a particular

28 form of cylinder by letter reference to the drawing, and therefore, that, in such a case, the combination was limited to the particular character of the cylinder. Certainly neither of these cases establishes a hard and fast rule that where a patentee claims the combination of certain elements shown in his patent, describing them by reference letters in the drawings, he thereby deprives himself of the benefit of the liberal doctrine of equivalents applicable to pioneer patents if otherwise he is entitled to its application. See *Delemater vs. Heath*, 20 U. S. Ap., 14; 7 C. C. A., 279; 58 Fed. R., 414. Whether he specifically claims in his patent the benefit of equivalents or not, the law allows them to him according to the nature of his patent. If it is a mere improvement on a successful machine, a mere tributary invention or a device the novelty of which is confined by the past art to the particular form shown, the range of equivalents is narrowly restricted. If it is a pioneer patent with a new result, the range is very wide and is not restricted by the failure of the patentee to describe and claim combinations of equivalents. Nothing will restrict the pioneer patentee's rights in this regard save the use of language in his specifications and claims which permits no other reasonable construction than one attributing to the patentee a positive intention to limit the scope of his invention in some particular to the exact form of the device he shows, and a consequent willingness to abandon to the public any other form, should it be adopted, and prove useful. Instances of such a limitation may be found in *Keystone Bridge Company vs. Phoenix Iron Company*, 95 U. S., 274, and in *Brown vs. Stilwell & Bierce Manufacturing Company*, 6 U. S. App., 234; 16 U. S., 234; 6 C. C. A., 528. But there is no such limitation in the patent under discussion and the rule applies which was so fully explained in *Winans vs. Demmead*, 15 How., 330, where the court said: "Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words." Again in *Goodyear Dental Vulcanite Co. vs. Davis*, 102 U. S., 222-230, the Supreme Court said that a patentee was protected against equivalents whether he claims them or not. A most satisfactory discussion of this general subject may be found in the opinion of the circuit

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court of appeals of the first circuit, in *Reece Buttonhole Machine Co. vs. Globe Buttonhole Machine Co.*, 61 Fed. R., 958, where Judge Putnam, on behalf of that court, examines the two lines of cases of which *Winans vs. Denmead* and the *Keystone bridge* case are respective types, and reconciles them so far as they may be reconciled. See also *Manufacturing Company vs. Adams*, 151 U. S., 139; *Muller vs. Manufacturing Company*, 151 U. S., 186.

With respect to the third, tenth and eleventh claims, we therefore, conclude that they are valid and that the defendants infringe them, unless by the application for reissue and the subsequent abandonment of it, either the scope of the claims was narrowed to a literal reading of them, or the validity of the claims was entirely destroyed. The effect of this reissue application we shall consider later.

We come now to consider the 25th and 26th claims; they are as follows:

25th. "The combination of arm Q on shaft K'' with arm R' and bent arm R'' on rock-shaft R and carrying the projecting cord arm r'" to force the cord from the knot-tying device, substantially as described."

26th. "The combination of arm Q on shaft K'' with arm R' and bent arm R'' on rock-shaft R, carrying the knife r' for cutting the cord, and arm r'" for forcing the cord off the hook, substantially as described."

These claims relate to the tying mechanism and to that part of it only by which the knot after it is tied, is stripped off of the knotting or tying bill and the cord connecting it with the cord-holder is cut. The shaft K'' of the knotting bill is centrally bored to receive the shaft of the cord-hook n^4 that extends upward into the shaft K''. The knot-tying shaft K'' has at its lower end another cord hook, z, projecting from one side and upward to receive and hold thereon the cord, so that, as the hook is revolved in tying the knot, the cord passes under the hook and forms the loop of the knot. In the lower curved surface of hook z is a radial groove, z', extending from the bore for the spindle that is in the center of the shaft K'' outward to near its terminal point. This groove is to receive the cord hook n^4 so that the loop in the cord will pass over the cord hook n^4 in forming the knot, as the shaft K'' is revolved. Shaft K'' is cut away on the hook side, from just above the hook, about half its diameter, and high enough to allow the cord-carrier to freely pass by in compressing the bundle and carrying the cord over the cord hook. The spindle of the cord hook n^4 is so connected with the shaft K'' at its upward end, that as the shaft K'' revolves in its bearing a cam attached to the shaft of n^4 working against a spiral spring slides the spindle downward and opens the bill between the cord hook z and the cord hook n^4 . The opening is so timed by the form and size of the cam as to receive the cord in the bill at the proper moment to tie the knot. Some idea of the operation may be obtained from the drawings shown below.

(Here follows diagram marked p. 30.)

31 The arm Q is a bent projecting arm from an eye q around the knot-tying shaft K'' and revolves with it. It is a rock-shaft working in bearings $r r$ that are fast to top of frame M. R' is a bent arm attached to the rock-shaft, and bending downward below the path of the revolution of arm Q, while another bent arm R'', passes on the opposite side of the rock-shaft downward, and curves toward, underneath, and past the knot-tying shaft K''. On arm R'', near its terminal end, is an upwardly projecting knife r' , to cut the cord, while further back from the end than the knife is a curved and upwardly projecting arm, r''' , to force the cord off the knot-tying hook after the cord is cut by knife r' . r^4 is a spiral spring fast at one end to the bent knife arm R'', and the other end fixed to the frame B. This device for cutting and removing the cord is operated by the revolution of the arm Q on shaft K'', which strikes against the lower part of arm R' and carries it forward, rocking the shaft and forcing the arm R'' on the opposite side of the rock-shaft that carries the knife and bent arm, to advance toward the knot shaft, the knife passing on one side of the shaft and severing the cord between the shaft and cord-holding wheels, and passing forward until the bent arm passes on the other side of the shaft, and forces the cord off the hook, and as this is accomplished the arm Q has lost its hold of arm R' when the spiral spring r^4 acts to pull the knife and bent arm on arm R'' back to their former position.

In the defendant's machine the means for moving the cutter and stripper is a cam flange on the face of a disk revolving not on the knotter shaft but on another shaft which drives other portions of the mechanism and which, through a beveled segmental gear, also turns the knotter shaft. This bevel gear is only segmental and passes the co-operating gear on the knotter shaft at a different time from that when the cam operates the two-armed lever upon which is the knife and stripper, so that the knotter shaft is at rest in defendants' machines when the knife and stripper are moving, while in Gorham they move at the same time.

Gorham took his knotting bill from a patent of one Behel issued in 1864 in which the two cord hooks forming the bill and co-operating to hold, twist and knot the cord were connected by a spring tending to hold them together. One of the cord hooks was pivoted to the knotter arm, the bent end of which formed the other cord hook. The bill was opened by the pressure of the knotting bill against the strained cord in such a way as to operate upon one end of the pivoted cord hook against the spring which held the two together so that as the knotter shaft turned twisting the cord around it, the cord ends were caught in the open bill and as the knotter shaft continued to turn the knot was tied. Then by swinging the knotter shaft on a segment, the cord between the bill and the knot-holder was carried against a stationary knife and cut. By the swinging back of the bill, the knot was stripped off of it.

32 There was a patentable improvement in Gorham's bill over Behel's bill, in the mode by which the cord hooks were opened by the use of a cam and a sliding sleeve, and in the working of the spindle of one cord hook in the shaft of the other. But

that Behel's knotter bill suggested and was the foundation for Gorham's is not disputed. Behel used a stationary knife against which he carried his cord by swinging his bill, and he used the backward swing of the bill itself to strip the cord from it, while Gorham substituted the bent-arm arrangement above shown. There were in the history of the art many knot-tying devices, and in every one of them it was necessary to cut the cord and to strip it from the device which knotted it. Gorham used the revolution of the knotter shaft with the bent arm to operate at the right time another bent arm carrying the knife and cord along the side of and parallel to the knotter bill. The defendant did not use the knotter shaft to operate his stripping and cutting device, but took another shaft, which at a different time from that when the stripper and knife were to be actuated turned the knotter bill.

In Hickey's knotting device the cutter was operated on a pivoted lever moved by a cam on a shaft other than the knotter shaft.

In Greenhut's grain binder, patented in 1868, the knife is actuated by a two-arm lever which is moved upon a cam flanged on the face of a cog wheel moving on a shaft other than the knotter shaft. This is in many respects quite like that of the defendant. We think that the state of the art was such with reference to knotters and strippers at the time when Gorham invented his knotter-bill knife and stripper that he is not entitled to claim as an infringement of his knife and stripper any device substantially different in form from that which he used. It is true that the knife and stripper of the defendant is moved by the shaft which also moves the knotter shaft, and that in Gorham's the knife and stripper is moved by the knotter shaft, and that this states generally the difference between the two, but considering the prior art, it does not state the difference with sufficient detail to prove or disprove their likeness for the purpose of deciding the question of infringement. No claim is made that the knotter bill itself is an infringement, and we are limited in this discussion to the question whether the knife and stripper infringe. Were Gorham's knotter bill and his knife and stripper pioneer patents, the resemblance between them and the same parts of defendants' machine would be sufficient perhaps to justify regarding them as equivalents, but they are not pioneer devices. Gorham and the defendants, or their licensor, Appleby, were acquainted with the prior art, and with that in view, they reached the same result, and one not new, in different ways. One improved on one device, and the other on another. We are considering Gorham's stripper and cutter in its character as an independent device for performing the function it discharges in his machine. The 25th and 26th claims are not for a combination of all the parts of his machine to accomplish his new result.

33 If they were, the knotter and stripper in Gorham's machine would of course be an equivalent of the defendants' as an element of the combination. Considered alone, however, and not in combination, as it must be under these claims, we hold that the defendants do not infringe it.

We come now to the question what effect, if any, shall be given to the application for reissue which was made by Gorham's widow, Helen M. Gorham, in 1881. In this application the 11th claim was as follows:

"The combination with the receiving chamber and binding receptacle of the guides D and vibrating segments provided with feed-teeth, substantially as set forth."

This was rejected by the Patent Office on the ground that it was anticipated by the patents of Elward, Childs, Gordon, Whitney and Barta.

The 14th claim was:

"In a grain-binder, the combination with a receiving chamber and binding receptacle of feeding mechanism and actuating mechanism constructed and arranged to pack the grain into the binding receptacle, substantially as set forth."

This claim was rejected on account of the patents of Heath, Childs, Spaulding, Whitney and Barta.

The 15th claim was:

"In a grain-binder, the combination with the binding receptacle of the binder-actuating mechanism a yielding strap and intermediate mechanism for automatically throwing the binding mechanism in gear with the prime mover and the toothed segments arranged and adapted to pack the grain into the binding receptacle, substantially as set forth."

This was rejected on the ground of the patents of Spaulding, Low & Adams, Elward, and Barta.

The 20th claim was:

"In a grain-binder, the combination with the binding receptacle, of a two-armed oscillating feeding mechanism constructed and arranged substantially as described and outer guides located substantially parallel to the line of movement of the oscillating feeding arms, substantially as set forth."

This was rejected on account of Low & Adams and Elward's patents.

The 13th claim of the original patent was:

"The vibrating segments having feed-teeth in combination with guides D as and for the purpose hereinbefore specified."

This was rejected on account of Low & Adams and Whitney patents.

The 16th claim was:

"The combination with a binding receptacle of a feeding mechanism and actuating mechanism arranged to pack the grain into the receptacle, substantially as hereinbefore set forth."

This was rejected on account of Childs, Hannah and Whitney's patents.

The 17th claim was:

34 "The combination of the flexible strap with the binding receptacle and toothed feeding segments, substantially as and for the purpose hereinbefore set forth."

This was held to be incomplete, superfluous so far as to its operation and to have been anticipated by Barto's patent.

An examination of the file-wrapper and contents of the reissue application satisfies us that the assistant examiner in the Patent Office held in effect by the rejection of the above claims that the 3rd, 10th and 11th claims of the original patent which we have found to be valid and to state the gist of the pioneer patent which Gorham invented, were anticipated in the prior art.

There were other claims, old and new, which the assistant examiner allowed and this was the condition of the application for reissue when the application was withdrawn by the following letter from the counsel for Mrs. Gorham :

" In the matter of the application of Marquis L. Gorham for reissue of letters patent granted herein February 9th, 1875. No. 159,506. Grain-binders.

To the honorable Commissioner of Patents:

SIR: The above application having been refused we request that the original patent may be returned to us in accordance with the provisions of the law.

Very respectfully,

PARKINSON & PARKINSON.

Sept. 21, 1882."

We find from the evidence in the record and the circumstances that the action of the counsel for Mrs. Gorham and the complainant in withdrawing the application for reissue was with no intention of abandoning their alleged right to a wide construction of the claims of the original patent. We do not find in the file-wrapper and contents any statements by complainant's grantor which merely as evidence upon the construction of the original patent and its claims would either limit or narrow them.

It is contended by counsel for the appellee that the abandonment of the application for reissue and the return of the patent after a rejection of the claims in the original patent create an estoppel against the patentee which prevents him from thereafter relying on those claims or asserting a monopoly under them. It is contended that the same rule must apply as in the case where one on an original application accepts a patent after acquiescing in the rejection of a claim. In such a case the patentee cannot be heard to assert that his invention as patented has the scope it would have had, if the rejected claim had been allowed. The basis of this rule is that one who seeks a patent from the Government is making a contract with the Government as to the extent and operation of a monopoly. If he asserts a claim which the Patent

Office rejects and he thereafter accepts a patent without the allowance of such a claim, the patent is issued on the condition of his acquiescence therein and he cannot be heard ever afterwards to deny the rightfulness of the disallowance. The Government parted with its patent on the faith of his acquiescence in the rejection of the claim, hence he cannot be permitted to revive it after having accepted the benefit of the patent without it.

In *Sutter vs. Robinson*, 119 U. S., 530, Mr. Justice Matthews used this language: "A comparison of the patent as granted with the application very conclusively establishes the limits within which the patentee's claims must be confined. He is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant. *Shepard vs. Carrigan*, 116 U. S., 593, and cases there cited."

It is difficult to see how such a principle can apply in the case of an application for a reissue which is not carried to the point of surrender of the patent and the acceptance of a new patent. Nothing is granted to the patentee which he did not have before and there is therefore, no privilege or benefit moving from the Government to the patentee upon which an estoppel can be founded.

It is further insisted, however, that the application for the reissue is a resubmission of the validity of the original claims to the Patent Office as a tribunal for adjudication and that when the claims are rejected by the properly constituted authority of that office and that rejection is unappealed from and therefore acquiesced in, though the patent be returned to the patentee, it is conclusively adjudged to be invalid to the extent of the claims rejected by the Patent Office.

Section 4916 of the Revised Statutes is as follows:

"Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications

36 and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.

Every patent so reissued, together with the corrected specifications shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specifications, nor in a case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention and was

omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

By this section, the Patent Office is given the authority to revise and restrict in the same manner as in the original applications, the specifications and claim for the reissue; but the same section provides that the surrender of the old patent shall not take effect except upon the issue of the amended patent and the question is whether the rejection of a claims for the reissue, which the patentee does not acquiesce in, by pressing his application for the reissue to a new patent for the allowed claims, invalidates the old patent, of which he secures the return.

In *Peck vs. Collins*, 103 U. S., 660, the question was whether under the patent laws in force in 1866 a patent had any validity, a reissue of which had been applied for to the Patent Office and rejected. It was held in accordance with the decision of *Moffitt vs. Garr*, 1 Black, 273, that the application for the reissue involved a surrender of the old patent at the time of the application. At the close of the opinion Mr. Justice Bradley used this language:

"Since the surrender of the patent in this case the patent laws have undergone a general revision by the act of July 8, 1870, C. 230. In the fifty-third section of that act (being the section relating to the surrender and reissue of patents) a new clause was introduced, declaring that the surrender 'shall take effect upon the issue of the amended patent;' and this clause is retained in section 4916 of the Revised Statutes. What may be the effect of this provision in cases where a reissue is refused, it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a reissue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue."

It will be observed that this remark of Mr. Justice Bradley was not necessary to the decision of the case, before the court. It was a *semble* and is so referred to in the head-note of the case. The
37 question has never since been considered and decided by the Supreme Court.

The members of this court have difficulty in reaching a conclusion upon the question thus suggested. It is one of much importance to all persons engaged in the procuring of patents and the remedying of their defects by applications for a reissue. Upon its answer turns the validity or invalidity of an otherwise very valuable and meritorious patent in this case.

We think it proper therefore to certify to the Supreme Court for its instructions the following question based on the facts as above stated:

"If a patentee applies for a reissue of his patent and includes among the claims under the new application the same claims as those which were included in the old patent and the assistant examiner of the Patent Office rejects some of such claims and allows others, both old and new, does the patentee by abandoning his

application for a reissue and by procuring a return of his original patent hold his patent invalidated as to those claims which the assistant examiner rejected?"

Finally we come to the question whether the defendants are liable to the plaintiffs for an infringement of the Baker patent which was reissued. This patent was for the improvement upon the mode of supporting the resistant finger or trigger in the Appleby twine-binding machine.

The patent may be best understood by reference to the following figure taken from the drawings.

(Here follow diagrams marked pp. 38 & 39.)

40 The drawings are thus explained in the specifications of the reissue patent:

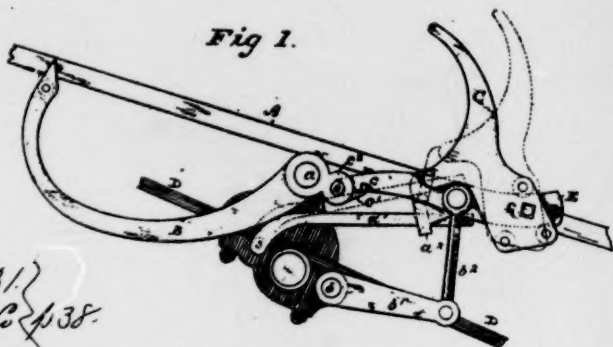
"E designates the bar or rod to which the tripping fingers are pivoted by a pivot, e' . This bar is hinged to a heel extension of the binding arm by an eye, e^2 , on said arm and a pin, e' , fixed on the bar and passing through the eye. The bar is supported in the position shown in Fig. 1 by a spring, b^4 , acting through shaft b and cranks b' b^3 and pitman rod b^2 against the body of the arm.

The machinery is tripped by the grain pressing the finger C back to the position shown in dotted lines, Fig. 1. In doing this the finger rocks on pivot e and elevates the projecting lug a^2 on the bottom of the finger, which raises the tripping lever a' , attached to shaft 3. The binding arm is operated by a rock-shaft, a , set in motion, as is the remainder of the intermediate binding mechanism, by the tripping of the clutch through these instrumentalities.

All of the parts as thus illustrated and described are not materially different from those well known in the class of machines to which reference is made.

In all machines of this class the bar or rod E, which carries the fingers which cause the tripping of the machine, is supported by a spring support, similar to that shown in Fig. 4, and it not infrequently happens, when the grain is damp or green, and from other causes, that the pressure of the grain against the bottom of the tripping fingers will cause the spring support to yield before the pressure at the top of the fingers is sufficient to cause their backward or rocking movement upon their pivot. The yielding of the spring in this manner allows that end of the bar E to which the fingers are pivoted to be borne down and lowered in its position, so that the backward movement of the fingers, taking place after such lowering, will not elevate the trip-lever, and hence the binding mechanism will not be started, nor where the packers are to be stopped will they be thrown out of action, and the machine will clog. To avoid this difficulty and remedy the defect I lock the supporting bar positively against descent until the tripping movement of the fingers takes place, for this purpose making the hinge between the binding arm or its rock-shaft and the finger support E such as to support this bar in the position shown in Fig. 1, irrespective of the spring-support—that is, the hinge is made entirely

Fig 1.



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Fig: 2

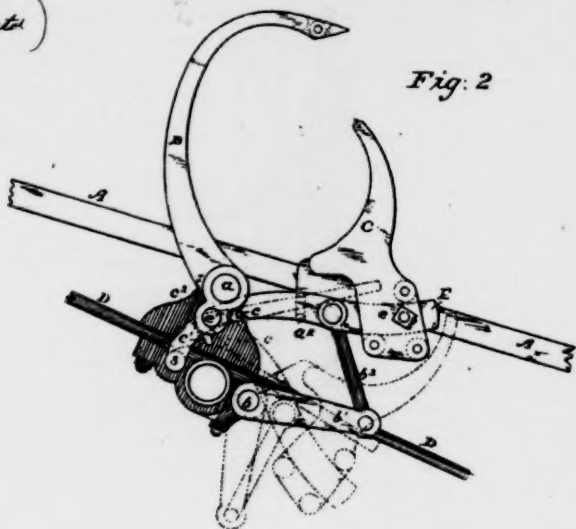


Fig. 4.

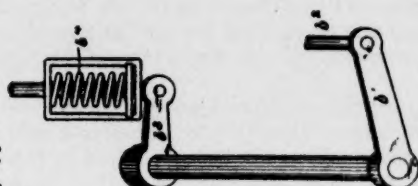
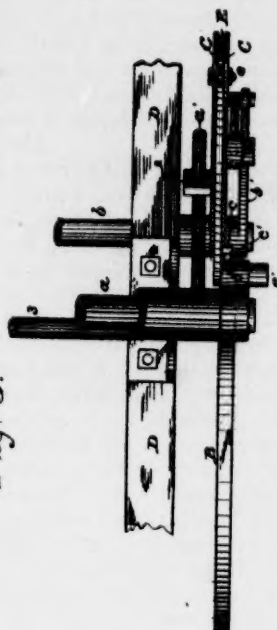


Fig. 3.



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 Aultman & Co

rigid at this point, so that it will not allow the other end of the bar to drop and lower, whether it has or has not other support. This rigidity of the hinge at the point desired is best secured by means of a pin or lug *c*, upon the bar *E*, and a lip or projection, *c'*, upon the eye *c*², arranged to meet at the point desired and prevent any further turning of the hinge. This affords a reliable support to said bar, and insures the tripping of the mechanism under all circumstances. As soon as the fingers have operated the trip, the

41 binding arm starts upon its upward movement, thus breaking the lock by carrying the lip *c'* away from the pin *c*, and the bar is free thereafter to be lowered at the proper moment to allow the discharge of the bound bundle. The return of the binding arm to its first position renews the lock at the moment the clutch is thrown out, and the parts will be again ready for a fresh binding operation."

What Baker did was to put a lug on the finger bar to operate against another lug on the needle bar at its heel in such a way that when the cam-rod spring had yielded sufficiently under pressure of the grain the finger bar would be rigid with the needle bar as it lay down at rest beneath the deck and further spring action in the cam rod would be prevented. When, however, the needle was up and squeezing the gavel, the lug on its heel was drawn out of the way of that on the finger bar so that when the time came for the cam rod to allow the resisting finger and finger bar to fall away from in front of the bound gavel, the lugs on the finger bar and the needle bar no longer locked and no longer interfered with this result. This was all that Baker claims to have invented. Everything else in the device shown in the above drawings and description was old.

The Baker patent was reissued but it is conceded by complainant's experts that all the claims were substantially as limited in the original patent. The sole claim in the original patent which was repeated in the reissue as the fifth claim was as follows: "In a grain-binder a support, *E*, for the compressing and tripping fingers *C*, hinged to the binding arm, in combination with a pin, *c*, on support *E*, and a lip, *c'*, on the binding arm, all arranged to operate substantially as and for the purpose specified."

In the defendants' machine, a lug locks with the heel of the needle arm so as to secure substantially the same result. If the invention is not void for the want of novelty, there is no doubt that the defendant appropriated the Baker device. We are of opinion, however, that the patent is void for want of invention. It was quite old in this particular art and in every other, where two arms were pivoted together, to limit the angle of their separation by lugs or stops which should come in contact at the joint or hinge. In the Appleby machine, the needle arm and the finger bar were hinged. Until the spring was introduced in the cam rod, there was no necessity of measuring and limiting its yielding capacity by making the finger bar and the needle arm rigid. As soon as the cam rod however came to have a spring in it, a patent for the present device was applied for by Baker. In Appleby's patent for

a twine binder issued in 1869, the angle of separation between a compressor arm and a needle arm was limited by just such a device. The same device was also shown, in various forms, to limit the operation of a spring used to bring together the binding arm and the resistant arm in a twine binder invented by Locke in 1869. The claim made is that the use of the needle arm by Baker as the leg upon which to lock the finger arm was particularly ingenious because the locking and rigidity of

42 the finger arm could not be permanent but must end, for the purpose of permitting the discharging apparatus to work, as soon as the gavel was bound and tied, and that the invention consisted not in the mere use of lugs or stops at the hinge of two arms whose divergence was to be limited, but in the selection of the needle arm at rest as one of the legs whose divergence was to be limited and whose function, as such, would cease as soon as it began to move, thus allowing the finger arm freedom of motion at a time when in the organization of the machine, it became necessary to have such freedom. Had the locking device not been shown twice in the art previously as applied to the binder arm and the resisting arm in the same class of machines, it might be that it would have involved the inventive faculty to use the binder arm for such a purpose, but we think it was most natural as soon as it became necessary to limit the operation of the cam-rod spring, for any one in an examination of the prior art, to see that the device in the Locke and Appleby 1889 patent would serve the desired purpose. The hinging of the resistant arm on the heel of the needle arm which was old, obviously suggested the use of the needle arm as the means of limiting the motion of the resistant arm. Nor do we think the fact that the locking of the binding arm and the resisting arm in this instance had an added function, namely of ceasing to lock when the needle arm was elevated, should change this conclusion.

For these reasons we do not think the claim of infringement on the Baker patent can be sustained.

The result of our discussion of this case leads to an affirmance of the decree of the court below in so far as it holds that the 25th and 26th claims of the Gorham patent are not infringed and that the Baker patent is invalid for the want of novelty.

We differ with the court below, however, in the view which it took of the 3rd, 10th, and 11th claims of the Gorham patent and we think that, unless by the subsequent application of the reissue these claims were invalidated, the defendants' machine infringed them and the complainants are entitled to recover damages therefor.

We shall hold the case, therefore, until the question as to the effect of the application for a reissue has been submitted to the Supreme Court and that court's instructions thereon are certified to us, and it is so ordered.

43 UNITED STATES OF AMERICA, } ss:
Sixth Judicial Circuit,

I, Frank O. Loveland, clerk of the United States circuit court of appeals for the sixth circuit, do hereby certify that the foregoing certificate and opinion in the cases of McCormick Harvesting Machine Co. v. C. Aultman & Company *et al.*, and McCormick Harvesting Machine Co. v. Aultman-Miller Company were duly filed and entered of record in my office by order of said court, and, as directed by said court, the said certificate and opinion are by me forwarded to the Supreme Court of the United States for its action thereon.

In testimony whereof I hereunto
 Seal United States Circuit subscribe my name and affix the seal
 Court of Appeals, Sixth of said court, at the city of Cin-
 Circuit. ciennati, this 5th day of February,
 1896.

FRANK O. LOVELAND,

Clerk U. S. Circuit Court of Appeals for the Sixth Circuit.

Endorsed on cover: (Certificate.) Case No. 16,188. U.S. circuit court of appeals, sixth circuit. Term No., 130. McCormick Harvesting Machine Company, appellant, vs. C. Aultman & Company *et al.*; and case No. 16,189, McCormick Harvesting Machine Company, appellant, vs. Aultman, Miller & Company. Term No., 131. Filed February 12th, 1896.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1897.

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|---------------------------------------|---|----------|
| McCORMICK HARVESTING MACHINE COMPANY, | } | No. 130. |
| <i>Appellant,</i> | | |
| <i>vs.</i> | | |
| C. AULTMAN & COMPANY ET AL., | } | |
| <i>Appellees.</i> | | |

| | | |
|---------------------------------------|---|----------|
| McCORMICK HARVESTING MACHINE COMPANY, | } | No. 131. |
| <i>Appellant,</i> | | |
| <i>vs.</i> | | |
| AULTMAN-MILLER COMPANY, | } | |
| <i>Appellee.</i> | | |

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

BRIEF FOR McCORMICK HARVESTING MACHINE COMPANY, APPELLANT.

STATEMENT.

The question certified, to which the issue here is confined, is stated on the first and second pages of the transcript. It does not relate to the effect which proceedings in the Patent Office might have on a grant derived through those proceedings, or the effect which the acceptance of a limited grant may have in concluding the party against asserting a broader title, but presents the question whether an inchoate attempt of the executrix of the patentee to amend the patent by reissue, which never passed into any public records, from which no grant was ever derived, under which no title was obtained or asserted, which was withdrawn with the avowed purpose of relying on and as-

serting the original patent instead of prosecuting the application for reissue, must operate as a cancellation of the claims which the owner of the patent thus refused to surrender and which the Patent Office itself never undertook to cancel.

The patent in suit is the *original* Gorham patent for "Grain Binder," dated February 9, 1875, a patent which, as found by the Circuit Court of Appeals, introduced the first automatic twine-binder that ever successfully bound grain in the field, and upon the substantial plan of which have been built practically all the grain-binders which have gone upon the market or into public use. (*Rec.*, pp. 2-16.) These defendants, who have built without license machines corresponding in all material respects to those which the other manufacturers were building under the patent, indicated their recognition of its value by entering into a contract with the executrix of the patentee from whom complainant had acquired title, by which they and their associates offered \$100,000 and all expenses of litigation if she would set aside complainant's title and assign to them. (*Rec.*, p. 16.) Failing in this, they are insisting that the claims of the original patent, which the court finds to embrace a novel and extremely valuable invention, and to be infringed by defendants, were forfeited by a secret application for reissue made by Gorham's widow (acting as executrix) before complainant acquired control of the patent, and withdrawn before the form in which the reissue application should be presented for the final action of the Commissioner had been settled.

The Circuit Court of Appeals having found this invention to be one of extraordinary merit and originality, which solved a problem that had baffled inventors for many years and substituted the automatic twine-binder for hand-binding, has submitted to this court the question whether the original patent was invalidated by an application for reissue made by the executrix after the death of the patentee, and withdrawn before any final action had been taken upon it, the complainant, who had meanwhile acquired title to the original patent, having prevented further prosecution of the application for reissue by demanding and obtaining from the Patent Office the

restoration of the original patent without cancellation or modification of any kind.

The widow of the patentee, being also his executrix, filed in the spring of 1881 an application for a reissue of this patent, containing, in addition to the claims in the original, various new ones. This was before *Miller v. Brass Co.*, 104 U. S., 350, overruled the doctrine of *Marsh v. Seymour*, 97 U. S., 348; *Corn Planter Cases*, 23 Wall., 181; *Seymour v. Marsh*, 11 Wall., 316, and other cases reaching back to *Grant v. Raymond*, 6 Pet., 218, which were generally understood to have authoritatively construed the law as conferring the right to reissue at any time during the life of the patent for the purpose of inserting claims covering

“not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings or Patent Office models, which properly belonged to the invention as actually made and perfected.” (97 U. S., 348.)

It was then a common expedient to reissue a patent for the sole purpose of inserting additional claims and giving it a more imposing appearance, without much reference to whether the original patent was legally adequate to protect the invention. Adding to the number of claims in this way was popularly supposed to add to the commercial value of the patent. If this widow had gone with the most adequately drawn patent that ever issued to the average patent solicitor of those times (who, for the most part, were not lawyers, and found a profitable occupation in applying for reissues) and stated that she wished to sell such patent, the first suggestion would generally have been to reissue it with additional claims. Such additional claims were often inserted, not because the original claims were insufficient to protect the invention under recognized rules of judicial construction, but because of a desire to express them in language more impressive to the trade and to persons unfamiliar with these rules of construction, or because the solicitor advised claiming features shown in the patent but not included in the claims.

Such applications go, in the first instance, to one of the sub-

ordinate examiners or clerks in the Patent Office, who is charged with making, for the instruction both of the Commissioner and of the applicant, the examination provided for in Section 4893 of the Revised Statutes. It is his duty to inform the applicant by letter of any prior patent which, in his opinion, may require modifications of either the specification or claims (which he usually does by saying that certain claims are "rejected" on the references specified), leaving the applicant to examine the references thus cited and determine whether, in view of them, he prefers to insist upon the allowance of these claims in their original form or to modify them so as to express more clearly the distinctions between his invention and the references cited, or to erase them altogether and accept the patent with these claims omitted. Such "rejections" conclude nothing. The applicant may by letter or by oral argument satisfy the examiner that he has mistaken either the prior devices or the essential character of the present invention, and obtain his approval of the claims thus rejected, or he may modify the claims so as to embrace the invention quite as broadly but in language more satisfactory to the fancy of the examiner, or to express in the claims themselves the distinctions which he regards as already sufficiently implied by the specification but which the examiner has overlooked; or, if satisfied that the references are entirely irrelevant, he may refuse to make any changes or to further discuss the matter with the examiner, and insist upon the allowance by the Commissioner of the application as drawn, including all the claims objected to by the examiner. The examiner has no power to adjudicate the rights of the applicant either affirmatively or negatively. He can refuse to approve the application until formulated in terms that conform to his fancy, and if the applicant refuses to alter the application and insists upon its allowance without alteration, he may report to his superiors the grounds of his objections or "rejections," and leave them to determine whether they are well taken. He is not the *Patent Office*, but a clerk in that office. He is not even one of the "Examiners-in-Chief" provided for in section 476 of the Revised Statutes, but one of the clerks au-

thorized by section 169. The fact that he assumes an air of authority in his correspondence does not change its advisory and confidential character. He has no power to either issue or withhold a patent, though if the applicant, either by accepting his suggestions or by persuading him that his objections are not well founded, obtains his approval of the application in the form in which it is then expressed, the proper officials would ordinarily issue the patent as the result of such approval, unless they saw some special reason for ordering otherwise. Nothing is consummated until the patent is issued. This correspondence is confidential and not matter of public record. It is a means of settling as far as possible, by exchange of views between the examiner and applicant, the form in which the application will finally be insisted upon for the action of the Commissioner, or of making up the issues to be passed upon by the Commissioner. It often happens that the examiner is a novice, either in respect to the class of machinery with which he is dealing or in respect to the rules of legal construction, and, misled by some superficial resemblance, cites references which are altogether foreign to the invention and withdraws his objections when the differences are explained by the applicant or his solicitor. Sometimes his principal concern is to get temporarily rid of the application while appearing to keep up with his work, and he does so before making any careful examination of specification or claims, by "rejecting" on any prior patents that show a visual resemblance to some of the elements claimed, thus transferring to the applicant or his solicitor the burden of pointing out and explaining to him thereafter the essential distinctions between the references and the pending claims.

These rejections are only preliminary to a further consideration of the case, and are often followed by an allowance of the rejected claims by the same examiner.

Mrs. Gorham's application for a reissue met this usual treatment at the time it was filed, and had not passed beyond this preliminary stage when the original patent (which, under the law then and ever since in force, was not surrendered until the reissue was granted) was purchased by the complainant and

others whose title complainant afterwards acquired. They insisted on their right to the original patent, stopped the attempt to reissue, and obtained from the Patent Office the return of the original patent (which was filed with the application under a provision of the statute by which it required that it be cancelled *when the reissue was granted*), and promptly brought suit upon it.

The reissue application was therefore withdrawn before any final action had been taken upon it by the Patent Office, or any surrender of the original had taken effect, and the title upon which complainant now stands rests upon the original grant (not upon a grant derived through this reissue application), whose validity and construction is committed solely to the judgment of the courts rather than to the Patent Office. The complainant, acting on the assumption that the patent did not require amendment, and unwilling to incur the delay and other disadvantages incident to prosecuting or accepting a reissue, asserted its right to rely upon the original patent, which was immediately available to it, and to thus carry the controversy directly into a court which had jurisdiction (as the Patent Office had not) to finally determine the validity and scope of that patent and administer relief thereunder.

These cases were heard in the Circuit Court before his Honor Judge Jackson, then circuit judge. He held that by withdrawing the application for reissue and bringing the suit on the original patent the complainant had acquiesced in the objections which the examiner had made in his correspondence to claims of the reissue application; that this operated as a cancellation of all similar claims in the original, and that the files of this reissue proceeding (which never passed to a grant) superseded the title which the complainant held under the original patent and controlled the construction and validity of that patent. He cited as supporting this action such cases as *Robinson v. Sutter*, 119 U. S., 54, and *Shepard v. Carrigan*, 16 U. S., 595, apparently not distinguishing between the effect which proceedings in the Patent Office might have in explaining the meaning of ambiguous language in a grant growing out of such proceedings, or the effect which the ac-

ceptance of certain restrictions might have upon a grant which issued in consideration of such restrictions, and the case of a patent which did not grow out of such Patent Office proceedings, which had not been changed in terms in consequence of such proceedings and the issue and acceptance of which long antedated such proceedings. He seems to have confounded the withdrawal of the application for reissue before there had been any final action upon it, and the immediate assertion of right under the original patent, with cases where amendments introduced in response to objections from an examiner, and thereby made a part of the grant under which title is asserted, have been referred to as explanatory of the terms of that grant; to have overlooked the fact that the Patent Office has no power to either cancel or restrict a patent after it has issued, except by granting a reissue to supersede it; and to have failed to distinguish between its power to determine in what terms it will make a new grant through a patent officially signed and sealed, and the insufficiency of a confidential letter of a subordinate in the Office to alter the legal effect of an existing patent which the Patent Office determined to leave unmodified.

The opinion of the Circuit Court treated the assertion of the right before the only tribunal which, under modern decisions, had any jurisdiction to determine the validity of an existing patent as an abandonment of that right. It confused the confidential preliminary correspondence of an examiner, never adopted or acted upon by the Office, with a "judgment" and the election to stand upon a prior existing title instead of submitting to the conditions of procuring the grant of a different title, with the acceptance of a title granted on such conditions. It undertook to create an estoppel against one who had neither misled others nor received advantage, and in favor of those who had been in no respect affected or prejudiced, and to create a condition of forfeiture unknown to the statute and unsupported by any equity. (58 Fed. Rep., 773.)

The Circuit Court of Appeals found, as appears in its statement and opinion, that there was nothing in these proceedings on the part of the applicant "which, regarded merely as evi-

dence or by way of estoppel, should limit or narrow the construction" of the claims in controversy (*p. 1*). It also found from the evidence in the record that the withdrawal of the application for reissue (*p. 27*) "was with no intention of abandoning their alleged right to a wide construction of the claims of the original patent," and said, referring to the application which the court had made below of *Sutter v. Robinson and Shepard v. Carrigan* (*p. 28*):

"It is difficult to see how such a principle can apply in the case of an application for a reissue which is not carried to the point of surrender of the patent and the acceptance of a new patent. Nothing is granted to the patentee which he did not have before and there is, therefore, no privilege or benefit moving from the Government to the patentee upon which an estoppel can be founded."

Having naturally great respect for the opinion of the judge who decided the case below and apparently entertaining some doubt about the significance of an expression of this court in *Peck v. Collins*, 103 U. S., 660, the Circuit Court of Appeals, after finding the patent valid and infringed unless the proceedings in the Patent Office operated as a cancellation of the claims in the original, has certified to this court for its instructions the following question (*p. 2*):

"If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the primary examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?"

It is insisted in behalf of complainant below that the original patent remains in force for its full term unless meanwhile superseded by the grant of a reissue or cancelled by a decree of court; that the Patent Office has no power to modify a patent once issued, except through the grant of such a reissue as the owner may accept in lieu of the original; that even if it had

such power it has not exercised it in this case, but has acquiesced in the election of the assignee to withdraw the application for reissue and assert right under the original, by returning the original unmodified; that if in the judgment of the purchaser of the patent or of its counsel the original patent was adequate and a reissue unnecessary the only legitimate and honest course was to withdraw the application for reissue (which the law only authorized where the original patent was defective) and submit directly to the court the question of the validity and construction of the patent already in force; that in taking this course complainant neither relinquished any right which the original grant conferred, nor acquired any benefit from the reissue application, nor inflicted any prejudice upon the public; that such objections as the examiner made to claims submitted to him could not alter the nature of the original patent until they were accepted and given effect by the promulgation of a reissue conformable to them, under the seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner, which would thenceforth supersede the original patent as the source of title and definition of right; that until thus acted upon they could not be taken as indicating what judgment the *Patent Office* (or even the examiner himself) would ultimately reach on the propriety of allowing these claims in the terms in which they were expressed, nor did they indicate the opinion of the examiner on the very different question whether such claims, when in a patent, were capable of such a construction as would sustain them and make them effectual; that if, from the standpoint of the Examiner, claims submitted for allowance seemed capable of a construction which would cover prior machines, that might be a reason for refusing to recommend their inclusion in a new franchise which was still subject to revision, and for requiring the applicant, as a condition of obtaining the examiner's approval of the proposed amendments, to so draft these claims as to express in terms satisfactory to the examiner the distinctions on which the patentee relied, when, in passing upon the validity of the same claims in a patent already in force, governed, as

he must be, by the rule, *ut res magis valeat quam pereat*, the same examiner would have no hesitation in sustaining the claims with a construction that abundantly distinguished the invention from the prior art; that the court in passing upon the validity of the original patent could give as much or as little weight to the objections urged against them by the examiner as in its judgment they deserved, and determine (as it has done in the present case) whether the claims were entitled to a construction that distinguished them from the prior patents on which the examiner had based his objections, and, if satisfied that they were, when read in connection with the specification, entitled to a construction that made them valid notwithstanding these references, it was its duty to so adjudicate; that its judgment, however it might be influenced by, was not subordinated to, his opinions thus tentatively indicated; that the obligation to determine the validity and interpretation of the original patent rested upon the court and could not be shifted to an examiner who had no part in framing that patent; that there is nothing in the terms of the statute to require such a forfeiture as is here contended for by defendants below, and no legal or equitable consideration to justify it; that the *sempre* in *Peck v. Collins*, invoked by the Circuit Court, refers to the effect of an *adjudication* by a decree of court upon an issue which that court had jurisdiction to determine, and has no application to such advisory correspondence of an examiner as never resulted in a decree or grant of any kind; that the decisions upon the effect of Patent Office correspondence on the interpretation of claims resulting from such correspondence give no support to the proposition that correspondence subsequent to the patent in suit can supersede, abrogate or nullify the claims with which that patent issued, or to the proposition that such correspondence can operate to expunge claims from patents which receive no modification in consequence of it and are not derived through it; that the jurisdiction of the Office was confined to determining whether it would issue a new grant to replace the original, and in what terms that new grant should be expressed, while the question whether the old grant was valid or invalid was, until it was

superseded by the grant of a reissue, a question solely for the courts; that if it were to be imagined that the Patent Office had any control of the original, that control was voluntarily surrendered by it when it returned the patent uncanceled and unmodified; and that this return of the patent, including all the original claims, being subsequent to the letters of the examiner, would supersede them in effect, so far as they can be supposed to have any effect, and must be considered either as the decision of the Office to permit the applicant to retain and assert the original patent without modification or qualification, or as a recognition of the right to withdraw the application without prejudice and assert the original franchise in the courts having jurisdiction to construe and adjudicate it.

THE ORIGINAL PATENT WAS NEVER SUPERSEDED OR MODIFIED.

A patent issued *under the seal of the Patent Office*, duly signed and countersigned, is the instrument provided by statute for defining the franchise with which the patentee is vested. It is a public document, uttered in the name of the United States, authenticated by the officials who alone have power to consummate such a grant. Thenceforth it defines the right which the grantee is entitled to assert throughout its term, and the jurisdiction to determine its validity and scope is committed exclusively to the federal courts. The Patent Office cannot, during its term, abridge this franchise except by issuing an "amended patent" (commonly called a "reissue") to supersede it. This it is authorized to do only on certain specified conditions. It has the same power to revise an application for reissue as it has to revise an application for an original patent, and these revisions, *when consummated* by the issue of the amended patent containing them, have the same effect on that amended patent as similar revisions in an original application have upon the original patent, controlling to the same extent all claims asserted under the amended patent in which they are incorporated. But the power of revision relates to the patent which is issued on the pending application, and is only exercised in framing and issuing that patent. It only becomes

operative when consummated by the issue of that patent with such revisions included therein. Until such issue, there is no *determination* concerning the extent or character of the amended patent; no *adjudication* of rights; no *acquisition* of right; no *acceptance* of conditions or restrictions; no *consummation* of any kind. A letter of an examiner addressed to an applicant urging objections to certain claims is only advisory and preliminary to further proceedings. It concludes nothing as to the terms or scope with which that pending application may be finally allowed, and is in no sense a "*judgment*" or "*adjudication*" of any issue. The judgment of the Patent Office is expressed by the public grant of a patent under its official seal, not by the confidential correspondence of a subordinate examiner out of which no grant ever sprung. Such correspondence is neither published nor open to public inspection. The fact that such an application was made is treated as confidential, the public having no notice or intimation of it until the patent issues upon it. Copies of such withdrawn applications can only be obtained by those connected with its prosecution or by a special order of the Commissioner in person upon a petition showing the applicant to be informed of its existence and to have some special equity entitling him to a copy. (*United States, ex rel. Bulkley v. Butterworth, Com.*, 81 Off. Gaz., 505; *United States, ex rel. Fowler*, 62 Off. Gaz., 1968.)

If it had been intended that such letters of subordinates in the Office were to supersede and cancel the claims of patents issued under the great seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner, some provision would have been made for giving them public official expression.

The first section of the statute relating to patents (Revised Statutes, 4883) provides that—

“ All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the

Patent Office, in books to be kept for that purpose."

Certainly it was not intended that a grant thus formally authenticated, promulgated and recorded should be subjected to modification by the unpublished, confidential letters of any clerk or examiner in the Patent Office to whom was committed the task of in the first instance making the investigation preliminary to the issue of another franchise.

The same enactment provided in terms for the cancellation or modification of a patent in two ways: *first*, by a decree of court under certain specified conditions, and, *second*, under certain other specified conditions, by the issue of an "amended" patent which should from the time of issue supersede the original patent as the *grant* through which the patentee derived title. No provision was made by which an *examiner* could either diminish or enlarge the grant after it had once issued. If it had been intended that he should exercise that power some provision would have been made for the publication and authentication of his act. The examiner or clerk is not *the Patent Office*. Not even the Commissioner can individually restrict or recall or modify a grant which has once issued in the manner prescribed by law. A letter from the Commissioner, though signed by him as Commissioner, would be inoperative to cancel or modify such a grant. Such a letter can no more recall or cancel a government grant than confer such grant. Any utterance by the Commissioner, other than the actual grant of a patent, though in the form of an official certificate of correction intended to modify a patent already granted, is inoperative and without legal effect. (*Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. Rep., 300, C. C. A., Second Circuit.) The examiner may, by preliminary investigation and correspondence, help to inform both the Commissioner and the applicant about the propriety of issuing a patent and the kind of claims proper to be allowed. If the applicant accepts the advice of the examiner and voluntarily modifies his application to conform with the views of the examiner, the Commissioner may, if he chooses (though he is not controlled thereby), cause it to pass to issue in that form, and, when issued with the

formalities required by law to give it force, it becomes conclusive on the applicant so far as any rights asserted thereunder are concerned. But the work of the examiner is only advisory, and has no legal effect in either conferring or restricting a franchise except as it may be adopted and acted upon in the formal grant, duly signed and sealed, by which the Patent Office registers its official acts.

In *ex parte Starr*, 15 Off. Gaz., 1053, decided by Commissioner Payne shortly before the application for the reissue here under consideration, the fact that a rejection by an examiner was only preliminary to a consideration of the issue by the examiner, that it concluded neither the examiner nor the Patent Office nor the applicant, and that no action short of the official allowance of the patent could be regarded as settling the action of the examiner, was very distinctly pointed out, while in *ex parte Neale*, 15 Off. Gaz., 511, the same Commissioner held that the Patent Office was not concluded either by the action of the examiner in finally allowing the patent, or by the completion of other formalities, including the affixing of the Commissioner's signature, if the patent had not been both signed and sealed, as required by law. In the first mentioned of these cases the Commissioner says (p. 1054):

"The rules require an Examiner to notify the applicant of a rejection without delay; but if such notice is not followed by an amendment, the Examiner is not precluded by this action from a reconsideration. On the contrary, he is authorized and required, at the request of the applicant, to reconsider, and, upon such reconsideration, may either affirm or reverse his first decision. I find no provision in the law or rules for the communication to the applicant of a favorable decision on the merits, either as to the whole case or as to particular objections met or abandoned, except the provision for an official notice of allowance. I think there ought not to be any other provision in the law or rules. I doubt the wisdom of such a provision.

"... But it seems to me that, up the time when this official notice of allowance is given, the judgment and conscience of the Examiner ought, so far as the merits of the case are concerned, to be as unfettered as is that of the court up to the moment when a judgment is signed, whatever questions, answers, suggestions, or intimations

of opinion may or may not have been made on the trial or during the pendency of the case.

“While an Examiner is obliged to reconsider, at the applicant’s request, after one rejection, he is not obliged to reconsider after a second rejection of the same claim. A motion by an applicant for such a reconsideration would ordinarily be overruled. But if the Examiner himself should, upon further scrutiny or reflection, encounter considerations satisfying him that he had made a mistake, he would be at liberty to reconsider his rejection and pass the patent to issue. It appears, therefore, that in all cases a reconsideration of the merits by an Examiner, on his own motion, is permissible until the official notice of allowance is given.”

That the Commissioner is charged with the final duty of determining whether a patent shall issue and that nothing is concluded until the patent is both signed and sealed is also very clearly stated in the decision of the Secretary of the Interior *in re Hunt*, 13 O. G., 771, and in *Hall v. Commissioner of Patents*, 2 McArthur, 90. See, also, *Butterworth v. Hoe*, 112 U. S., 50, particularly pp. 52, 59, 64, 66.

The examiner could not cancel any claim in the application pending before him. He could only refuse to recommend its allowance, leaving the applicant, if unable to overcome his objections by argument, either to express the claims in terms more satisfactory to the examiner (and which might be quite as comprehensive in legal effect), or to insist upon the same claims before the examiners-in-chief or the Commissioner in person; or, if, as in the present case, he preferred to take the judgment of the court on the grant already in existence rather than spend time in seeking a new grant, he could withdraw his request for an amendment of the patent and assert his right under the patent in the original form, in the court having jurisdiction to construe and enforce it. If, before the surrender had taken effect, the executrix who filed the application concluded, under advice of new counsel, that the original patent required no amendment, or if the purchasers of the patent (which the public records showed to be still in force) were unwilling to surrender it, or were advised that there was no occasion for reissue, it would have been folly,

if not worse, for them to prosecute the application for reissue, when the Office would immediately restore them the original uncanceled. If the original specification and claims were, in their opinion, adequate, the conditions under which the law authorized the grant of a reissue did not exist. Any reissue granted pursuant to the application might be held invalid as not authorized by statute. No opinion that the Patent Office might be induced to express concerning the validity of the claims of the original patent, or the right to additional claims, could control the court in which relief must ultimately be sought. The most direct method of taking the opinion of such court was that which the complainant took with the acquiescence of the Patent Office. It is immaterial whether it took this course because advised by its counsel that the original patent was, under the usual rules of legal construction, adequate to secure the essential features of the invention, or because its counsel doubted the jurisdiction of the Patent Office to grant any reissue so long after the date of the original, where the specification was not fatally defective, or because it understood better than the executrix the relative value of an original patent which was immediately available for the purpose of prosecuting infringers. If advised that the patent did not come within the conditions under which a reissue was authorized; that the jurisdiction of the Patent Office to entertain such an application was doubtful; that, so far as the reissue intended to secure new claims, it was, under decisions subsequent to filing the application, barred by lapse of time between the grant of the original and the application for reissue; and that, so far as it related only to the original claims, no amendment of the original patent was necessary, and the proper remedy was by suit in court rather than by prosecuting an application before the Patent Office, they could not properly or consistently do otherwise than stand upon the existing title, withdraw the application for its amendment, and submit the original patent to the judgment of the proper court.

If a party desires to change the terms of a contract already in existence, and submits it to the opposing party for amendments, and the amendments are incorporated therein and a new

contract containing them executed and delivered in lieu of the original, that new contract must thereafter control the rights of the parties. But if the opposing party insists upon cancelling some of the provisions of the old contract as a condition of executing the new, and, the other party declining to accede to these conditions, no new contract is ever executed but the old one is returned in its original form at the request of the party first proposing these amendments, it certainly could not be reasonably contended that it must be henceforth treated as subject to all the modifications insisted upon as a condition of amending it. Yet such contention would be quite as reasonable as that here urged in behalf of the defense.

If the action of the examiner is to be treated as carving out of the original patent such claims as he had not approved for the purpose of the reissue, when did the original patent become thus mutilated? Was it when the examiner wrote these letters? Was the original patent changing character with every successive private letter of the examiner, when it could not yet appear but what either he or those controlling his action would allow every claim asked for? Did it take effect when the patent was returned? For all that appears, the Patent Office may then have been satisfied that the applicant was entitled to all the claims of the original. The return of the patent, uncanceled and unmodified, certainly indicates that it had reached no conclusion which warranted it in modifying that patent, and that it conceded the right of the patentee to continue to assert that patent precisely as if no effort to reissue it had ever been made. It would be a strange inversion of logic to treat this return of the patent in its original form as an official cancellation of it or any part of it. It was the plainest possible recognition of the right of the applicant to withdraw without prejudice and seek his remedy under the original grant in the proper tribunal.

The statute has provided that any assignment of a patent or of an exclusive right thereunder must be recorded in a public record kept for the purpose, in order to affect subsequent purchasers without notice. Can it be that any purchaser of a patent which is still in force is liable to find that its principal

claims have been cancelled by the confidential correspondence of an examiner over a reissue application, when the public records contain no hint that any reissue application was ever filed, and no suggestion that the patent has ever been modified?

THERE WAS NO ABANDONMENT OR CANCELLATION OF THE ORIGINAL PATENT OR ANY PART OF IT.

If the Patent Office had the power to cancel any portion of the original patent in any other way than by reissuing it (and it would seem clear that it had not), it is certain that it never exercised that power in this case. On the contrary, the only determination which it reached was to permit the original patent to remain unchanged and restore it to the parties in interest without addition or subtraction. It acquiesced in their withdrawal of the application for amendment and their election to stand upon the original grant, before any amendment had been made or any agreement or settlement reached with reference to what amendment would be allowed. It treated the examiner's correspondence as affording no sufficient reason for destroying the existing franchise or cancelling any part of it. It gave no official effect to that correspondence, but, so far as it decided anything, decided to leave the original patent in force, precisely as if no application for reissue had been filed. It terminated the proceedings by returning this original patent, to remain its only official expression concerning the franchise, the public authentication and definition of the patentee's right, without making any entry upon it or upon the public records of the Office to indicate that it saw occasion to alter or restrict it. That original had been filed with the application, partly to show that the executrix had custody of the original grant at the time of applying for this amendment, and partly to enable the Patent Office to cancel it when a reissue should be granted to supersede it—the only time at which, under the statute, it had any power to cancel or alter it. The application had never reached the stage when the statute authorized its cancellation or when a surrender of it could take effect.

If the Patent Office acquired, by the pendency of this application for amendment, any such control of the original patent as would enable it to refuse to restore it, if requested before a reissue had been consummated, its action in returning the patent in its original form must be regarded as the nearest approach to a "judgment" or "adjudication" reached by it, and as expressing its conclusion to permit the claims of the original patent to remain in operation as its official declaration of the rights secured to the patentee. If the Patent Office had no such control over the original as to give it discretion to refuse the return of the patent without revision whenever requested by the parties in interest prior to the grant of a reissue, it certainly had no power to change its legal effect or to withhold any part of the franchise conferred by it. It made no attempt to exercise such power.

The right to withdraw an application for reissue, and the fact that by such withdrawal the original is left in force, has been expressly recognized by this court. (*Allen v. Culp*, 166 U. S., 501).

The request for the return of the original patent was made before it appeared whether the Patent Office would or would not officially adopt the views of the examiner either in respect to allowing the new claims which he had approved or in objecting to such of the old claims as had not thus far been approved by him, and before it appeared whether the examiner himself would finally insist upon his objections or admit that they were not well taken. It was made before the applicant had cancelled the claims in dispute or accepted any modification of them, and before any expression of the examiner had become binding either upon the Office or upon the applicant. How could this direct assertion of right to the unmodified original patent on the part of the assignee, and this assent to that assertion of right on the part of the Patent Office, operate to destroy the right thus asserted and recognized, or any part of that right? How could the decision to stand upon the original patent be interpreted as an abandonment of the rights purporting to be secured by that patent? Why should this be distorted into anything but the withdrawal of the request for

amendment of the existing franchise, the election to rely upon the original grant without addition or subtraction, and the concurrence of the Patent Office in relegating all questions affecting the validity of that patent to the courts having jurisdiction to administer an existing franchise?

The Court of Appeals has found (*Rec.*, p. 27, at the bottom of p. 1) upon the evidence before it that the withdrawal of the application for reissue was "with no intention of abandoning the alleged right to a wide construction of the claims of the original patent," and that there is nothing in the files "which merely as evidence upon the construction of the original patent or its claims would either limit or narrow them." It is not pretended that anybody has been misled or in any way prejudiced by this application for amendment lodged by this executrix in the secret archives of the Patent Office and withdrawn for the express purpose of asserting the original patent before any amendment had been granted and before any knowledge of the application or proceedings thereon had become public; nor is it pretended that the defendants, or the public, had any knowledge of the reissue application until long after they had by these suits been made definitely aware of the fact that complainant was still asserting, and relying upon, the original grant. They could then only ascertain that such application had been made through the betrayal of confidence by some person who had been privy to it, and, whenever through such privy access was obtained to this correspondence, it showed unmistakably that the parties had elected to assert the original grant instead of amending it, and that the Office had sanctioned that election by returning it to them unmodified. The application had affected no one, except as it had burdened the estate of the patentee with the expense incident to it. The government is paid in advance the full charge for examining reissue applications, and the fees exacted are so much in excess of the cost to the department that a large surplus is carried over to the treasury every year.

The distinction between an abandonment of an *application* and an abandonment of the *invention embraced in that application* has been repeatedly recognized by the courts.

In *Lindsay v. Stein*, 20 Blatch., 370, a case decided shortly before this reissue application was withdrawn, there had been an application for a patent which was twice rejected on reference to prior patents which the examiner insisted anticipated the invention. After the second rejection it was abandoned and allowed to become forfeited under the statute. A new application was made for the same invention more than three years after this last rejection, and after this abandonment had been concluded by the statute. The court (Blatchford, J.) held that the abandonment of the application after rejection did not operate as an abandonment of the invention, and sustained the patent allowed on the subsequent application, saying (p. 376):

“The defendant contends that the effect of the Act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned application, and the applicant must stand, as to defenses in suits on the patent, as if the new application were the first application.”

The patent there under consideration was granted in 1878 and governed by the law in force at the time the patent here in suit was granted and the application for reissue made and withdrawn.

If the *abandonment* of an application after rejection does not affect the right to make a *similar* application thereafter, there would seem to be much stronger reasons why the withdrawal of an application for *amendment*, with the avowed purpose of asserting the *original franchise* (which is simultaneously withdrawn from the control of the Office), should not affect any rights secured thereunder.

Abandonment or forfeiture of a right is never to be inferred where the circumstances are fairly capable of any other interpretation. Certainly it is not to be inferred from conduct which expresses unmistakably the intention to assert that right—which is in fact the most positive assertion of it as a continuing right.

**WITHDRAWAL OF APPLICATION FOR AMENDMENT NOT TO BE CONFUSED
WITH ACCEPTANCE OF EXAMINER'S SUGGESTIONS.**

Instead of accepting the views of the examiner as indicated by his correspondence, and modifying the application to correspond therewith, the owners of the patent refused to modify their application in conformity therewith, declined to surrender the original patent, and resumed custody of it.

The Circuit Court appeared to confuse this case with those where rejections and amendments in the proceedings through which a patent acquired the form in which it issued have been treated as explanatory of the *grant thus formulated*, or where a cancellation or qualification of claims objected to by the examiner, and the acceptance of a grant bearing upon its face the restrictions thus imposed, has been held to estop the patentee and those claiming under him from asserting, *under a patent thus obtained*, rights which were excluded from it as a condition of its allowance.

Manifestly none of the reasons for treating the correspondence which resulted in the grant of a patent as *explanatory of the terms* of that grant, or for treating the *adoption* of restrictions in the claims of a patent as controlling upon a *grant thus obtained*, are applicable here.

The patent in suit was not derived through the correspondence here invoked, but existed in its present form long before that correspondence occurred. No modification in its terms was made in consequence of such correspondence. Its language is the same as when it first issued and cannot mean either more or less than it did then. The examiner who conducted the correspondence had nothing to do with framing the patent in suit. It does not appear that he was connected with the Patent Office at the time it issued. The parties to the re-issue application, instead of acquiescing in the views of the examiner and amending the application accordingly, refused to abandon the original claims or to accept anything less than the original franchise, and the Patent Office, instead of annulling the patent, left it in force. There could be no more emphatic refusal to accept the opinions of the examiner and no more

direct method of insisting upon the original claims than that taken in this case. It said plainly that instead of further discussing with the Patent Office the propriety of granting such a reissue as the executrix had asked for, the present owners of the patent would leave the franchise in its original form and take the opinion of the courts on the validity and sufficiency of the claims which it already contained.

The decisions which have referred to the proceedings in the Patent Office preliminary to the grant of a patent as explanatory of the significance of terms used in that patent have proceeded upon the theory that the meaning of such terms might sometimes be explained by the circumstances under which they were introduced. Even in this aspect, such evidence has to be considered with great caution. The correspondence cannot *overrule* the terms in which the grant is finally expressed, for the official grant must be taken as the last and decisive expression of the Patent Office. The rule which prevents a contract from being modified by preliminary correspondence applies with special force in cases where (as in the prosecution of an application for a patent) part of the proceedings are expressed in writing, and part, which sometimes determines the language in which the instrument is issued, may be oral and not appear in the records. It has been held that such files could do no more than explain the significance of the terms of the patent when consistent with such terms. They cannot contradict or overrule or supersede the terms in which the instrument is issued. To admit that any portion of the specification or claims of a patent could be *nullified* by expressions of opinion on the part of subordinates in the Office during the preliminary examination and correspondence would be to set at defiance the well-established rules controlling the construction of instruments and grants. The proposition of the defense here goes much further than this, and seeks to make such correspondence nullify the terms of an existing grant of government which was not formulated by the examiner expressing these opinions, or derived through any proceedings of which they were a part.

**THE PATENT OFFICE NEITHER ADJUDICATED NOR EXPRESSED OPINION
UPON THE VALIDITY OF ANY CLAIM IN THE ORIGINAL PATENT OTH-
ERWISE THAN BY RETURNING THAT PATENT UNMODIFIED.**

The correspondence between an examiner and an applicant is for the purpose of enabling an applicant to determine whether he will insist upon his application in the form originally submitted or put it in such form as meets the approval of the particular examiner to whom it is in the first instance referred. The examiner has no power to alter the specification or claims in any respect, but if they seem to him capable of a construction that would cover prior devices, or objectionable in any other way, he may object to them, informing the applicant of the nature of the objections and giving him an opportunity either to satisfy the examiner that the objections are based on misapprehension, or to accept the views of the examiner and modify the application in accordance therewith, or to refuse to defer to the judgment of the examiner and prosecute the application in the original form, in which latter case the Commissioner may either accept the views of the examiner or reject them, according as he thinks them well taken or otherwise. This correspondence of the examiner is only preliminary and advisory. His expressions are in no sense "judgments" or "adjudications." The judgment of the *Patent Office* is not expressed and does not become operative except through the formal grant, properly sealed, signed and countersigned. It does not become an expression of the opinion of the Office upon the matters under discussion except as consummated by a grant adopting officially the conclusions of the subordinate. It does not even indicate the opinion of the subordinate examiner upon the legal effect of the claims of the original patent, for the question whether certain claims were such as he would approve for allowance when entrusted with advising the Commissioner as to the terms in which he would recommend the issue of a new grant was very different from the question whether such claims in a patent already in existence were capable of such a construction as would sufficiently distinguish the invention from the prior art, and hence of being sustained so as to

effectuate the purpose of the grant. The question which arises where an instrument is to be revised is essentially different from that which arises where the validity of that instrument is to be adjudicated. An examiner in considering whether he will approve an application for allowance may object to claims which do not recite the distinctions between the invention and the prior art in as apt language as he thinks desirable, when a court having to pass upon the validity of claims in a grant already in force may hold that such claims, when read in connection with the specification, sufficiently distinguish the invention from the prior art, and are entitled to be sustained, though it may think them so inartificially drawn that it would have revised them if charged with that duty. An examiner who has certain fancies in determining the language in which he will advise the issue of a patent, often objects to a claim merely because, when read apart from the specification and without reference to the invention exhibited in that specification, its terms may seem to him to be satisfied by some prior device entirely foreign to the invention disclosed in the specification, when, if the same examiner had submitted to him the question whether these claims in an existing patent were entitled to such a construction as would distinguish the invention of the patent from that of the prior art, he would not have the slightest hesitation in answering that question in the affirmative. A lawyer who is charged with revising an instrument before it is executed may strike out phrases and insert others to reconcile the instrument to what he considers the best form of expression, or to embody in express terms distinctions which might otherwise be left to implication, when, if the same instrument was submitted to him after being executed in its original form, he would unhesitatingly pronounce it valid. The form of expression and the extent to which the claim shall recite the necessary association of the elements referred to, or leave them to be determined under the words "substantially as and for the purposes specified," by referring back to the title, statement of invention and description which precede, is a subject upon which the practice of the subordinates in the Patent Of-

fice differs as much as the same number of lawyers might differ in the expressions which they would recommend for the embodiment of a contract; but this does not mean that any of them having to pass upon the validity of a claim once issued would hold it invalid, because it did not conform to the restrictions which they would have imposed if entrusted with the task of formulating it. The opinion of the Circuit Court of Appeals, and the statement accompanying it, shows that the examiner had approved various claims which were added to those in the original patent (and which he apparently considered as better definitions of the invention), also that the court examined all the references upon which he based his objection to the claims not approved and found that none of these references met the claims in controversy, under the construction placed upon them by the court. The presence of these new claims, reciting in terms qualifications which the court has found to be implied in the original claims, might have indicated to the examiner that these original claims were not intended to be thus limited in the reissue application, when if they had not been associated with these new claims, but stood as in the original, he would have allowed them, putting the same construction upon them as the court has. The significance of a claim may be greatly changed by the context. The discussion of these claims and of the references cited by the examiner, found in the opinion of the court, illustrates how superficial the preliminary action of the examiner was and how improper it would be to confound his action with a judgment or decree in a court of law. Defendants have had the benefit of whatever weight the opinion of the examiner concerning the effect of prior patents upon the claims in controversy was entitled to. The court in examining those prior patents and determining that they do not conflict with the claims in controversy (under the construction which it placed upon those claims) has had the benefit of these objections as fully as the Commissioner would have had if the question of allowing these claims had been carried before him in some other form than by a request for the return of the original patent.

Stress was laid by the Circuit Court upon there being no

appeal taken from the action of the examiner; but whether the course taken be or be not regarded as technically an "appeal," it was in every material sense an *appeal to the court* by the most direct method which the law afforded. The proceeding had not reached a stage in which an appeal could be taken in any other way, and if this was not a proper case for *reissue*, this was the only way the question of the validity of these claims could ever be submitted to any tribunal having jurisdiction. If there had been no other franchise in existence upon which the parties could present the issues to the court, their remedy might have been confined to a technical appeal or a bill in equity for the grant of the patent. The existence of the original patent gave them a more expeditious and convenient method of carrying the matter before the court. If they wished to secure any advantage from the application for reissue, any amendment or enlargement of their franchise, their remedy was by pressing their reissue application before the Patent Office, but if they wished to take the opinion of the court upon the validity and sufficiency of the *original patent*, the only proper course open to them, the only legitimate method of transferring the controversy from the examiner to the court, was that which they took. It meant a refusal to accept or be concluded by the opinion of the examiner, quite as plainly as any technical appeal could, and a submission of the rights conferred by the original grant to the court.

As the law then stood, the withdrawal of an application for reissue and the assertion of the original grant in a court having jurisdiction was, in a case of this kind, the simplest and most direct, if not the only method provided by statute for taking the opinion of the court upon the validity of the original claims.

The law has long recognized the impropriety of leaving applicants for patents to be concluded by a bureau which is not a legal tribunal, and in which knowledge of the law is not exacted as a condition of holding either the office of Commissioner or the position of examiner. Under the Act of 1836, as amended March 3, 1837, express authority was given to applicants for

patents who were dissatisfied with the action of the Office to bring a bill in equity before the Circuit Court to obtain a decree compelling the issue of such a patent as the Office refused to grant, and the same remedy was given in terms to applicants for reissue as well as to applicants for original patents. See Section 16 of Patent Act of 1836 (Walker on Patents, p. 542); Amendment of March 3, 1837, Section 8 (Walker on Patents, p. 550), and Amendment of March 3, 1839, Section 10 (Walker on Patents, p. 555). The Act of 1870 repealed prior acts, and while retaining the right to file a bill in equity to compel the issue of a patent where one had been refused by the Patent Office, did not in terms extend that remedy to applicants for reissue, but instead provided that the surrender of a patent for the purpose of reissue should only take effect "upon the issue of the amended patent," leaving the patentee still at liberty, if the Office refused to allow him such a reissue as he sought, to stand upon his original patent and take the opinion of the Circuit Court upon his rights thereunder. Care was taken to guard against placing him in any position where the Patent Office could destroy a patent over which the Circuit Court had jurisdiction while refusing to grant him one which he was willing to accept in its stead, and to preserve to him the right of recourse to the Circuit Court upon the original grant down to the time that grant had been superseded by his acceptance of a new grant.

The caution which has for many years been observed in framing the patent laws to protect the inventor against being concluded by any action of the Patent Office which was unsatisfactory to him, is in marked contrast to the theory of the defense that every expression of an examiner adverse to the applicant concludes him in respect to rights asserted under a grant which that examiner had no part in formulating, and in spite of the fact that the applicant, with the concurrence of the Patent Office, instead of accepting the views of the examiner, promptly removed the controversy to the courts having jurisdiction, by the most direct method afforded by statute.

The opinion of the Circuit Court of Appeals indicates that it was only out of deference to a *dictum* of this court in *Peck v.*

Collins, 103 U. S., 660, that it hesitated to overrule the defense founded on the reissue application, and that it saw no reason, either equitable or statutory, why the proceedings had upon the application for reissue should disturb the original grant or any rights which might otherwise have been asserted thereunder.

When it is observed that this *dictum* occurred in a case where the court was considering the effect of a *decree of court* in an *inter partes* controversy, *concluding both parties* as to the issue, and that this was the kind of "adjudication" to which this *semble* referred, it is apparent that the case gives no support to this defense or to the conclusion reached by the Circuit Court concerning it. The only suggestion which it contains is as to the effect of a *final judgment* of a court *having jurisdiction to determine the exact issue*, where that judgment is officially entered and not appealed from, and where the same judgment would have concluded the adverse party if it had gone against him.

In *Peck v. Collins* the patent had been surrendered under the law in force prior to 1870, by the provisions of which the surrender of the patent took effect upon the *filing* of the application for reissue (the statute having been changed in 1870, apparently for the express purpose of avoiding the harshness of this rule, so as to provide that a surrender should only take effect on the *grant* of the reissue), and while that application was pending an interference had arisen between the patentee and a party asserting that he, rather than the patentee, was the original inventor of the subject-matter in controversy. The litigation over this question had been carried to the Supreme Court of the District of Columbia and resulted in a *final decree* of that court adjudging that the opposing party, rather than the applicant for reissue, was the original inventor of that subject-matter, and ordering that the patent issue to him instead of to the applicant for reissue, and the patent had issued accordingly. The applicant for reissue was thus left without any patent, either original or reissued, and the fact that he was not the inventor of the subject-matter had been adjudicated by a court of competent jurisdiction,

whose decree had been duly entered. After the surrender of the patent the patentee entered into a contract to sell it to parties who were not informed of the surrender. The litigation arose over the deferred payments under that contract, which were resisted on the ground that the patent had been extinguished before the contract was made. The court sustained this defense, pointing out the difference between the effect of the old statute and the new. Recognizing the fact that under the new statute the patent did not become extinguished until the issue of the amended patent, it intimated (though it expressly disclaimed deciding) that, even under the present statute, if in the application for a reissue the (p. 665)

“title to the invention is disputed and adjudged against him it would seem that the effect of such decision would be as fatal to his original patent as to his right to a reissue.”

What the court here means by “*title to the invention is disputed and adjudged against him*” is plainly a *dispute* and *judgment* of the nature there under consideration—that is, a definite and final determination of the specific issue by decree of a court having jurisdiction of that issue, which, if it had gone the other way, would have equally concluded the opposing party. It did not intimate that anything less than a *judgment* officially entered as the final and conclusive disposition of the issue submitted to it, by a court having jurisdiction of that issue, could have any such effect, or that the distinction between a judgment and a mere expression of opinion was any less material in dealing with rights held under patents than in dealing with other rights. There is no resemblance between a case where the issue has been “adjudged” and a case, like the present, where the nearest approach to any official action was to return the patent unmodified, and thus relegate all questions concerning it to the courts having jurisdiction to enforce and adjudicate existing patents.

This court in a recent case, after citing *Peck v. Collins*, and referring to the distinction between the old law and the new, quoting the provision that the surrender “shall take effect up-

on the reissue of the amended patent," said (*Allen v. Culp*, 166 U. S., 505):

"These words were obviously inserted for the purpose of preventing the surrender taking immediate effect, and to postpone its legal operation until the patent should be reissued. When a patent is thus surrendered, there can be no doubt that it continues to be a valid patent until it is reissued, when it becomes inoperative; but if a reissue be refused, it is entirely clear that the surrender never takes effect, and the patent stands as if no application had ever been made for a reissue. . . . But if the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for, unless at least the reissue be refused upon some ground equally affecting the original patent. If it were otherwise, every patentee who applies for a reissue would do so at the peril, not only of having his application refused, but of losing what he already possessed. This was the very contingency the act of 1870 was designed to provide against."

It would seem from the context that by the expression "unless at least the reissue be refused upon some ground equally affecting the original patent" the court meant either to avoid concluding the question suggested by the *dictum* in *Peck v. Collins*, when that question was not involved in the case before it, or merely to recognize the fact that any *ground of objection* to the reissue which was equally pertinent to the original would be available as a defense to the original, and its sufficiency as a defense would have to be determined by the court precisely as its sufficiency as a reason for refusing the reissue would have to be determined by the Patent Office. It would not be consistent with the context to read this language as implying that whatever an examiner objected to in the preliminary correspondence was thereby forfeited, for this would involve the very peril against which the court holds that the act of 1870 was designed to provide. It would deprive the patentee of control over the original, prior to the time when the surrender would take effect. It would compel him, when making an application for reissue, to incur the peril "of losing what he already possessed," if the examiner to whom the case was in the first instance referred cited references to the

original claims, no matter how foreign to the invention those references might be. It would exclude him from carrying the question of their validity directly before the court, even though he ascertained upon legal advice that there was no statutory ground for reissue, or found that the prosecution of the application for reissue was likely to involve more loss of time or more expense than he was willing to incur.

The Circuit Court of Appeals in the present case has expressly found that the references on which the examiner rejected the claims of the reissue application did not affect the validity of the claims of the original or present any reason why they should not be upheld and enforced.

In *Phelps v. Harris*, 101 U. S., 370, an action in ejectment was brought to oust the defendants who claimed under a partition made by Henry W. Vick. It appeared that the plaintiff had before brought against these defendants a bill in equity under a statute authorizing such bills to remove a cloud from the title to real estate. The defendants had answered to that bill in equity, pleading title under this partition. The matter had been litigated through the Supreme Court of the state, which had held that the Vick partition was good and rested its judgment in favor of the defendants on this finding. The plaintiff thereupon brought the suit in ejectment, and the judgment in the former case was pleaded in bar. The question whether this issue was *res adjudicata* was directly before this court. It determined it in the negative, pointing out the fact that, while the court in the former suit had based its decision upon the ground that the title under the Vick partition was good, the real question before that court was whether it was sufficiently clear that that title was bad to justify it in setting it aside, and that its opinion upon its validity, therefore, did not bar the action in ejectment or conclude the plaintiff against there litigating the same issue. This court said (p. 376):

“It is true that the court, in the former part of its opinion, discussed the question of the validity of the partition made by H. W. Vick and his son, and held that the partition was good, and that the title of Henry G. Vick to the lands in controversy was perfect, and, as a consequence, that the defendant's title was also perfect.

But this discussion was entered into for the purpose of showing that the title of the defendant was not so devoid of validity as to constitute a mere cloud on the title; and consequently that the case was not one in which a court of equity could give relief.

"We think, therefore, that the court below was right in determining that the decree in the equity case did not render the main controversy *res adjudicata*, but only decided that the bill would not lie; in other words, that it was not a proper case for a court of equity to determine the rights of the parties."

The difference between the question of approving claims for the purpose of embracing them in a new grant and the question of the validity of similar claims in an existing grant was much wider than the difference between the aspect in which the validity of the Vick title was presented in these two cases; and the decision in the chancery suit, which was held not to conclude the plaintiff, was carried to final judgment, duly entered in both the lower court and the court of final resort, while in this reissue application the Patent Office had taken no action concluding anybody upon any issue.

In *Russell v. Place*, 94 U. S., 606, this court held that a former judgment could only conclude parties "upon a question directly involved," and that

"if, upon the face of a record, anything is left to conjecture as to what was necessarily involved and decided, there is no estoppel in it when completed and nothing conclusive in it when offered as evidence."

In *Smith v. McCool*, 16 Wall., 560, this court held that a verdict without a judgment is of no validity, and quotes with approval the following passage from Greenleaf, underscoring the word "~~determination~~^{ed}" (p. 561):

"It is only where the point in issue has been *determined* that a judgment is a bar. If the suit has been discontinued, or the plaintiff becomes nonsuit, or for any other reason there has been no judgment of the court upon the matter in issue, the proceedings are not conclusive."

It then holds that where there had been a special verdict in an action in ejectment and the court below had rendered a judgment in favor of plaintiff on that special verdict, and

upon a writ of error this court had reversed that judgment and ordered judgment on the same special verdict to be rendered in favor of defendant, and it had been so rendered, this special verdict upon which judgment had been rendered did not conclude the plaintiff (who was the plaintiff in the former suit) in respect to the issue found by that verdict, in a subsequent action of ejectment upon a new title which would be affected in the same way by that issue, saying (p. 562):

“But neither the judgment of a concurrent nor exclusive jurisdiction is evidence of any matter which came collaterally in question, though within their jurisdiction, nor of any matter incidentally cognizable, nor of any matter to be inferred from argument.”

It laid stress on the fact that the party or his counsel might have regarded the issue in the former suit as not vital, since they were relying on propositions of law under which they claimed the judgment should be in their favor irrespective of the finding in this special verdict, and that they ought, therefore, not to be concluded by that finding in a subsequent suit, saying (p. 563):

“He may well have been, and doubtless was, less careful to introduce his full evidence, and to contest the facts found, including the one which the verdict was offered in this case to prove, than he would have been but for the confident assurance that they were all immaterial in respect to the judgment to be given, which he claimed must be in favor of his client.”

In *Reed v. Proprietors of Locks and Canals*, 8 How., 274, this court, in overruling the contention that the verdict of a jury in a former case upon the same issue concluded the parties, said (p. 291):

“There was no judgment of the court upon the verdict, which alone could give it the force or effect of *res adjudicata*.”

See, also:

Danielson v. Northwestern Fuel Co., 55 Fed. Rep., 49.

Etna Life Ins. Co. v. Board of County Com'rs, 79 Fed. Rep., 575.

Haldeman v. United States, 91 U. S., 584.

An order for a judgment is not equivalent to a judgment, and does not become operative until the entry of the judgment that the party recover the sum awarded.

Macnevin v. Macnevin, 63 Cal., 186.

Eastham v. Sallis, 60 Texas, 576.

See, also:

Gray v. Noon, 66 Cal., 186.

Estoppels or forfeitures are not favored in law or equity. They are not to be lightly assumed or to be inferred from any circumstance consistent with a different explanation. They must arise from some wrongful act of the person against whom they are invoked by which the person in behalf of whom they are invoked has been misled to his injury. There must be a wrong on the one hand, and a victim of that wrong on the other.

In *Ketchum v. Duncan*, 96 U. S., 659 (666), the Supreme Court says that estoppel *in pais* "operates only in favor of a person who has been misled to his injury." In *Railroad Company v. Dubois*, 12 Wallace, 47, the same court says (p. 64):

"No principle is better settled than that a party is not estopped by his silence unless it has misled another to his hurt."

In *Branson v. Wirth*, 17 Wallace, 52, the same court says (p. 42):

"If one person is induced to do an act prejudicial to himself in consequence of the acts or declarations of another, on which he had a right to rely, equity will enjoin the latter from asserting his legal rights against the tenor of such acts or declarations. But, then, the person charged has an opportunity of explaining, and equity will decree according to the justice of the entire case."

In *Henshaw v. Bissell*, 18 Wallace, 255, the same court says (p. 271):

"There is, therefore, no case for the application of the doctrine of equitable estoppel. For its application there must be some intended deception in the conduct or declarations of the party to be estopped, or such gross negligence on his part as to amount to constructive fraud.

"An estoppel *in pais* is sometimes said to be a moral question. Certain it is that to the enforcement of an estoppel of this character, such as will prevent a party

from asserting his legal rights to property, there must generally be some degree of turpitude in his conduct which has misled others to their injury. Conduct or declarations founded upon ignorance of one's rights have no such ingredient, and seldom work any such result. There are cases, it is true, where declarations may be made under such peculiar circumstances, that the party will be estopped from denying any knowledge of his rights; but these are exceptional, and do not affect the correctness of the general rule as stated."

In the present case there has been no dishonest or inequitable act on the one hand, and nobody misled on the other.

In making application for reissue, with no apparent purpose except to introduce additional claims, the executrix was undertaking to make a use of the reissue law understood to be sanctioned by the federal courts through reiterated decisions for a half century. If this widow was in error in following the custom then prevalent, of applying for a reissue for this purpose, it hardly becomes the federal courts to deal harshly with her because of that error. At the time the application was filed, any student of their decisions would have advised her that this was a legitimate use of the reissue law. There can be no pretext that her act was dishonest or fraudulent in purpose, or that it injured anybody. It was recalled before it had taken any effect. She and the minor heirs to whom the patent belonged derived no advantage from it; the public was not prejudiced by it; the defendants in this case were entirely unaffected by it; it never appeared in the public archives; there was no warrant for anybody to go to such correspondence for an interpretation of a grant that had issued years before, or to rely upon it as superseding that grant; the law had provided but one method by which the Patent Office could correct or modify it, namely, by a reissue, and the Office had never reissued it; there was nothing in its records that purported to be a correction of the original grant, or even indicated the opinion of anybody concerning the validity or scope of the original patent; if there had been, it would not have been an authoritative utterance by any tribunal whose decision was conclusive; it represented at most only the suggestions made by a subordinate whose opinion was only tentative and con-

from asserting his legal rights to property, there must generally be some degree of turpitude in his conduct which has misled others to their injury. Conduct or declarations founded upon ignorance of one's rights have no such ingredient, and seldom work any such result. There are cases, it is true, where declarations may be made under such peculiar circumstances, that the party will be estopped from denying any knowledge of his rights; but these are exceptional, and do not affect the correctness of the general rule as stated."

In the present case there has been no dishonest or inequitable act on the one hand, and nobody misled on the other.

In making application for reissue, with no apparent purpose except to introduce additional claims, the executrix was undertaking to make a use of the reissue law understood to be sanctioned by the federal courts through reiterated decisions for a half century. If this widow was in error in following the custom then prevalent, of applying for a reissue for this purpose, it hardly becomes the federal courts to deal harshly with her because of that error. At the time the application was filed, any student of their decisions would have advised her that this was a legitimate use of the reissue law. There can be no pretext that her act was dishonest or fraudulent in purpose, or that it injured anybody. It was recalled before it had taken any effect. She and the minor heirs to whom the patent belonged derived no advantage from it; the public was not prejudiced by it; the defendants in this case were entirely unaffected by it; it never appeared in the public archives; there was no warrant for anybody to go to such correspondence for an interpretation of a grant that had issued years before, or to rely upon it as superseding that grant; the law had provided but one method by which the Patent Office could correct or modify it, namely, by a reissue, and the Office had never reissued it; there was nothing in its records that purported to be a correction of the original grant, or even indicated the opinion of anybody concerning the validity or scope of the original patent; if there had been, it would not have been an authoritative utterance by any tribunal whose decision was conclusive; it represented at most only the suggestions made by a subordinate whose opinion was only tentative and con-

cluded nobody, upon questions disconnected with either the validity or the scope of the claims of the original patent, and which were not consummated by any act of the Patent Office or adopted by the applicant.

This court has had sufficient occasion to examine the correspondence contained in the files of patents which have ultimately passed to issue to appreciate how little objections or "rejections" by subordinate examiners signify as to the ultimate action of the Office, or of the examiners themselves, upon the allowance of claims. It must have observed that it is a common practice with many of them to refuse applications in the first instance without critically examining them, citing whatever will give a plausible excuse for postponing more serious attention, as a preliminary to having the applicant or his attorney explain the prior art to them, or for other trivial reasons; that they are not *judgments* concluding the matter in dispute, but mere instructive references to prior patents, raising the issue whether, in view of them, the applicant will modify his claims or insist upon them in their present form, inviting discussion of their bearing upon these claims, and affording an opportunity to consider whether it is expedient to distinguish more clearly from the prior patents in the terms of the claims; and that it is the rule rather than the exception for examiners to recede from their objections after hearing argument, and allow the claims either in terms or with modifications which do not restrict their scope but merely adopt the examiner's peculiar fancies about forms of expression. What the Circuit Court has treated as a "judgment" of the Patent Office is not even such a final expression of opinion by the subordinate as must necessarily precede the submission of the question to the examiners-in-chief, who, in turn, are subordinate to the Commissioner. It is nothing but a suggestion preliminary to argument or explanation, which would have to be followed by further consideration on the part of this subordinate examiner before the claims could be considered by his superiors.

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This application signifies nothing as to the opinion of the executrix about the validity or scope of the original patent, if her

opinion upon a question of this kind were entitled to consideration. It was then customary to file applications for reissue whenever the original patent was considered defective in that it did not claim everything that the inventor was entitled to claim. The decisions out of which the reissue law grew had recognized this as a proper object of a reissue, and sustained patents in which the claims introduced by reissue were intended to cover portions of the machine that had not been covered in the original claims. This had been repeatedly recognized as a legitimate use of the reissue law under the present statute. In *Marsh v. Seymour*, 97 U. S., 348 (published shortly before this application was filed), the Supreme Court reiterated and applied its long recognized doctrine that a patentee was entitled in a reissue to (p. 356)

“include in the description and claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or patent-office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the description, specification, or claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the description, specification, or claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent-office model.

“Extended discussion of these principles is unnecessary, as they are well settled by the repeated decisions of this court, and when properly applied to the case before the court, they show that the third assignment of error must be overruled, for the reason that the new patent does not contain anything beyond what was well described or suggested in the specification of the original patent.”

The reissues which that court sustained in this language were for inventions not covered by the claims of the original, and were taken out thirteen years after the original, being second reissues.

Not only did this action, under such circumstances, imply no opinion on the part of Mrs. Gorham, touching the sufficiency of the original patent to secure the inventions referred to in

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The withdrawal of the application for reissue does not imply any doubt on the part of those who had succeeded to the title, or of their counsel, concerning their right to a patent containing every claim included in the application, and covering unmistakably all that was embraced in the original claims. It merely indicates that in their opinion there was no occasion for *reissuing* the patent. There was no reason why they should incur the expense and delay of prosecuting the application for reissue when the original patent would, in legal effect, by the usual doctrine of equivalents, cover the essentials of the machine. Their opinion that such was its effect was indicated by withdrawing the application and immediately filing suits upon the original. Entertaining such an opinion, it would have been folly for them to have squandered time and expense in prosecuting a reissue which could only take effect from the time of its grant, in the indefinite future. Moreover, the intervening decision in *Miller v. Brass Company*, coming after this application was filed, had cast doubt upon the *jurisdiction* of the Patent Office to entertain an application for reissue filed more than two years after the original patent was granted, where the original patent was valid and the only purpose of the reissue was to introduce additional claims. Under that decision the withdrawal of the application for reissue was the only consistent method of asserting the validity of its claims, for every argument in favor of the validity of those claims was an argument against the jurisdiction of the Patent Office. With these doubts about its jurisdiction, their withdrawal of the application while still in its incipient stage, before anything was concluded, and their assertion in court of the grant already in force, so far from being a renunciation

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of any rights held under the original patent, was an assertion of those rights and a prompt recourse to the only tribunal which had jurisdiction to construe and adjudicate a patent already in existence. It was in strict conformity to the intimations of this court that the right to apply for reissue was restricted to cases where there was actual mistake in the original rendering it inoperative. If satisfied that there was no such mistake in the original as this court held to be necessary to give the Patent Office jurisdiction over a reissue application, they could not make, or have the executrix or assignee make, the oath setting forth the mistake necessary to give jurisdiction for reissue under the new interpretation of the law. They could only withdraw the application for amendment and rely on the original grant. There is no reason why the applicant should be punished for having promptly relinquished the right of reissue, when this court, departing from former decisions, intimated that the Patent Office was not authorized to entertain such an application, and for having resorted to the course which the statute permitted in seeking a remedy under the existing patent through a tribunal whose jurisdiction was unquestioned.

Where there has been no semblance of fraud or bad faith of any kind on the part of the applicant, no benefit accruing to the applicant by the proceedings in the Office, and no acceptance of a substituted grant; where neither the defendants nor the public have been misled or prejudiced in any way during the pendency of the application; where doubt had meanwhile been cast by decisions of this court upon the jurisdiction of the Patent Office to grant a reissue in the absence of evidence of actual mistake in the original; where the Patent Office itself conceded the right of the applicant to withdraw the original patent in lieu of proceeding with the reissue application; and where it was immediately asserted as covering the subject-matter of the present controversy, before the only tribunal which had jurisdiction to pass upon the validity and scope of an existing patent; it would be a strange inversion of the presumptions against defeasance of existing rights, and of the rules governing equitable estoppel, to create out of these

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circumstances any forfeiture or impairment of the original grant. Certainly the presumption is that such a right continues in force until the grant is cancelled or decreed void by a court having jurisdiction to enter such a decree.

Suppose there had been a contract to which Gorham was a party, evidenced by a written instrument in force at the time of his death; that his executrix had proposed to the adverse party a modification of that contract and a draft of the proposed modifications had been submitted; that various objections had been made to the terms proposed in that draft and there had been more or less correspondence over it; that before any new instrument had been executed or agreed upon, and while the proposed modifications were still under discussion, she had, under advice of different counsel, elected to stand upon the original instrument, and had promptly withdrawn the proposal for amendment and brought suit on the existing contract; would any court seriously entertain the proposition that such correspondence could either defeat or impair the original instrument which both parties treated as in force until superseded by a modified contract? Would it be pretended that the proposed changes in the instrument, which had never been consummated, could deprive either party of any rights under the instrument that remained in force? Would a court treat with any respect the claim that the refusal of either party to incorporate certain additional provisions, or their insistence upon excluding certain provisions already in the instrument, concluded the opposing party against having the benefit of whatever provisions were in the original instrument as executed, or that they had not the same force and effect as if no efforts at revision had been made? Would such negotiations be competent evidence to modify or defeat the original contract? Was it in the power of the executrix to create an estoppel against a title which she held only in trust for the minor heirs, by any act from which they derived no benefit and others suffered no injury?

Any conduct which is fairly capable of a different interpretation cannot be construed into a waiver of a right, and the conduct here was not merely capable of an interpretation that implied no waiver; it was incapable of any interpretation other

circumstances any forfeiture or impairment of the original grant. Certainly the presumption is that such a right continues in force until the grant is cancelled or decreed void by a court having jurisdiction to enter such a decree.

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than the purpose to assert in the proper tribunal the title already granted.

The Circuit Court said that applicant should not be allowed to "experiment." It cannot properly be said that there was any "experiment" while the action of the Patent Office remained still undetermined. If while a cause is pending the plaintiff becomes satisfied that he has mistaken his remedy, or begun proceedings in the wrong court, does his withdrawal of suit with the express permission of that court, and prompt assertion of a different title in the court having jurisdiction to adjudicate that title, justify the latter court in holding that the "experiment" in seeking the wrong remedy or going into the wrong tribunal bars the plaintiff against relief under the title and in the court to which the controversy has thus been transferred? The Supreme Court has repeatedly held that the withdrawal of an application which had been refused by the examiner, and substitution of another covering in different terms the subject-matter of the first, was not an abandonment of or limitation on the substituted specification, but this would be rather mere "experimenting" on the Office than anything appearing here. See:

Godfrey v. Eames, 1 Wall., 317.

Smith v. Goodyear D. V. Co., 93 U. S., 486.

Bevin v. East Hampton, 9 Blatch., 50.

There is no principle of law which precludes a party who has asked for an amendment of a grant from withdrawing his application before any amendment has been agreed upon and standing upon the original grant which remains unmodified. There is no reason why, when a party has gone into one tribunal for relief, and while the cause is pending doubts have been cast upon its authority to grant relief, or other reasons have arisen why he prefers to seek relief in a different tribunal having unquestioned jurisdiction by relying upon a different title, the fact that he has at first mistaken his mode of relief or acted upon different advice from that which subsequently governs him should conclude him against asserting the different title in the proper court.

The assumption of the Circuit Court that there was any-

thing like an *acquiescence* in the adverse attitude of the examiner indicates a strange misconception of what took place. The executrix who filed this application, after the death of her husband, held the patent in trust for the minor children of the patentee. She had no power to release or forfeit any rights under the patent thus held in trust, except by exchanging the existing patent for a new grant, if she had in this way. Before anything concerning that application had been officially determined by the Patent Office, the title to the original patent was sold to parties who, when advised of the pending application for reissue, chose to retain the original. The Patent Office accorded them the right to take this course, and delivered to them the original franchise, unaltered, thus terminating the inchoate proceedings for reissue, which had never passed beyond the stage of confidential correspondence. Right under the original was thereupon promptly asserted by commencing suits under it. The return of this original patent containing the original claims, authenticated by the formal grant, sealed, signed and countersigned, as provided by statute, and resting upon the original grant, was the only disposition made of the application, and indicated that the Patent Office did not consider or intend anything which had occurred during the pendency of the application as affecting or qualifying any rights purporting to be granted in that patent.

The doctrine that the patent laws should, if possible, be so construed as to effectuate their purpose and secure to inventors to the full extent the exclusive enjoyment, for the term of the patent, of what they confer upon the public, has been too often expounded and applied by this court, through many of the most distinguished jurists who have sat upon this bench, to be lightly set aside. Neither the patentee nor his widow or children should be subjected to forfeiture of rights once acquired and duly authenticated, unless the statute unmistakably imposes such forfeiture, or some paramount equity compels it. If they sometimes take a course which greater wisdom or better knowledge of the law would teach them to avoid, they should not be punished so long as they withdraw before anything has been consummated or anybody been misled. Even though they ap-

proach a precipice, if they discover the peril in time to retreat, the court should not interfere to push them over it. If they are to be treated as *personæ non gratae*, there is no reason why they should be deprived of all the protection which the statute affords them, why the terms of the statute should be wrenched in order to destroy a grant which the government has given for a consideration paid and accepted, why courts of equity should exercise their ingenuity in depriving the inventor, his widow and orphans, of the salutary rule which in other cases requires such courts to seek to effectuate rather than destroy, why they should create new and unheard of doctrines of estoppel for their destruction, why they should lie in ambush to ensnare them or dig pit-falls in their paths. The most ingenious inventors are usually strangers to the subtleties of language, the practices of the Patent Office, and the technicalities of the courts. They can describe a machine and point out the parts of it which they consider essential, designating them in terms that are intelligible to themselves and to the public; they can do everything that is necessary to put the public in possession of their invention; but they are usually much less adroit in guarding against imposition than they are original in contrivance. They find it hard enough to hold their own against those who are seeking to appropriate their inventions and deprive them of their rights; but if, in addition to this, they must run the gauntlet of hostile courts eager to discover some act or expression that can be wrested into a forfeiture not prescribed by statute, and facile in devising doctrines of estoppel which will serve the purpose of destroying their rights, there are not many inventors who can survive this test. A learned court reading a patent as a criminal lawyer would an indictment, searching for some flaw which will afford a pretence for defeating it, and free to contrive and apply such novel doctrines of estoppel or forfeiture as those proposed by defendants, would be more than a match for any inventor, and have no difficulty in overthrowing any patent or so curtailing its effect that infringers could appropriate its substance with impunity.

It is submitted that the intent and effect of the withdrawal of the application for reissue and the return of the original

patent was to leave the original grant unchanged and relegate to the court all questions affecting its validity and scope precisely as if no application for its amendment had been made, and that the question certified should be answered accordingly.

Respectfully,

ROBERT H. PARKINSON,
Counsel for Appellant.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1897.

McCORMICK HARVESTING MACHINE COMPANY,
Appellant, }
vs. } No. 130.
C. AULTMAN & COMPANY ET AL.,
Appellees. }

AND

McCORMICK HARVESTING MACHINE COMPANY,
Appellant, }
vs. } No. 131.
AULTMAN-MILLER COMPANY,
Appellee. }

BRIEF OF ARGUMENT FOR APPELLEE.

May it please the Court:

These cases come up on a certificate from the United States Circuit Court of Appeals for the Sixth Circuit. They involve a single question of law that has never yet been decided by this court.

The actions in the courts below were suits in equity to restrain the infringement of letters patent No. 159,506, issued February 9, 1875, to Marquis L. Gorham, for

Improvements in Automatic Grain Binders. The defendants were charged with infringing, among others,³ the third, tenth and eleventh claims of the patent.

It appeared in the proofs that in 1881 the owner of the Gorham patent applied for a reissue of the patent, including in the application for the reissue many new claims and many of the old claims of the patent, including the third, tenth and eleventh claims—the ones, among others, in respect to which infringement was charged. The Examiner held that some of the old claims and some of the new claims should be allowed, but *rejected* the third, tenth and eleventh claims, among others, for *want of patentable novelty*. No appeal was taken, although the case was pending in the Office for nearly two years. The reissue application was abandoned, and the original patent, on request, was returned to the owner. After the return of the patent, suit was commenced on the third, tenth and eleventh claims, among others, which had been rejected *on their merits* for want of patentable novelty and on reference to prior patents.

In the Circuit Court Judge Jackson held that the third, tenth and eleventh claim of the patent were invalidated and no longer in force because of their rejection and the acquiescence of the owner of the patent therein without appeal. He accordingly dismissed the bills.

On appeal to the United States Circuit Court of Appeals for the Sixth Circuit, the court were in doubt as to the effect that should be given to the rejection on the merits and acquiescence in such rejection on the application for reissue, and certified up to this court the following question:

“If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the Primary Examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?”

The question above presents for determination the status of those original claims in a patent which are rejected on their *merits* and for want of patentable novelty on an application to reissue the patent. The question assumes that the rejection was right—that the claims were met. This question, as before said, has never been determined by this court.

Sec. 4916 of the Revised Statutes, which provides for the surrender and reissue of inoperative or invalid patents, says that:

“The Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued . . . such surrender shall take effect upon the issue of the amended patent. . . . The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.”

This court has twice had occasion to refer to this section of the statute, and has on each occasion reserved from

decision the question now under consideration, although employing language implying, as we think, that where original claims are rejected *on their merits*, as for want of novelty, the rejection would be fatal to such claims. We will quote from these decisions, so that the exact language of the court will be presented for convenient consideration.

In *Peck v. Collins*, 103 U. S., 665, the court, through Mr. Justice Bradley, in considering a patent that had been surrendered before the Act of 1870, said:

“ Since the surrender of the patent in this case the patent laws have undergone a general revision by the act of July 8, 1870, c. 230. In the fifty-third section of that act (being the section relating to the surrender and and reissue of patents), a new clause was introduced, declaring that the surrender ‘ shall take effect upon the issue of the amended patent;’ and this clause is retained in sect. 4916 of the Revised Statutes. What may be the effect of this provision in cases where a reissue is refused it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a re-issue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue.”

In *Allen v. Culp*, 166 U. S., 505, the court, through Mr. Justice Brown, in a case where the Examiner refused the reissue upon the ground of unreasonable delay and because the *new* claims were substantially anticipated—the decision of the Examiner not touching the *original* claims—said:

“ If the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for, unless at least

the reissue be refused upon some ground equally affecting the original patent."

This language recognizes that the rejection may be upon grounds which *do* affect the original patent—"equally affecting the original patent."

In the case now under consideration, the question is squarely presented for determination, whether the rejection of the *old* claims on their merits in reissue proceedings and the acquiescence in such rejection by the applicant invalidates such *old* claims. The question is based on the assumption that the rejection was right and that it was a mistake to have allowed the claims in the first instance. A decision of this question in the negative must operate as a holding that old claims, even though *exactly* met in prior references which had been overlooked on the original examination, can still be saved by a sharp applicant—by abandoning the reissue proceedings and withdrawing the patent. A decision of this question in the negative will be tantamount to a nullification of the provision in the statute that the specification and claims in a reissue application "shall be subject to revision and restriction in the same manner as original applications are," by putting it in the power of the applicant to abandon his reissue application, withdraw the original patent, and set at naught the judgment of the tribunal he had invoked in the hope of securing advantage.

Judge Jackson, whose decision was announced after he had been elevated to this court, in discussing the effect of the reissue proceedings now under consideration and in deciding the case on the circuit, in 58 Fed. Rep., 778, said:

"It is shown by the record that the owners of the

Gorham patent, in 1881, before its transfer and assignment to the complainant, filed an application in the patent office for a reissue thereof, which contained claims substantially, if not identically, the same as said original claims here involved, together with other claims which sought to broaden and enlarge the scope and bearing of said original claims. In acting upon this application the Patent Office not only denied the broader claims sought to be secured, but rejected the claims which were either a literal or substantial repetition of said claims 3, 10, 11, 25 and 26 of the original patent, on which the present suit is based. This rejection was rested or predicated by the examiner on reference to various prior patents. The owner of the Gorham patent took no appeal from this decision or adverse action of the patent office, but acquiesced in the same, and thereafter requested and obtained a return of the original letters patent; leaving the decision of the examiner, rejecting both said original claims, and the new claims presented to broaden the same, in full force and operation.

Now, what is the legal effect of this proceeding, and of the adverse action or decision of the department thereunder, upon said claims 3, 10, 11, 25 and 26? In withdrawing or securing a return of the original letters patent after an adverse decision by the patent office on said claims, is the patentee, or his successor in right and interest, entitled to assert the validity of said claims or insist upon the benefit thereof, unaffected by the reissue proceedings and such adverse action? We think not. It is well settled that the rejection of such claims on an original application, and acquiescence in such rejection, would conclude the patentee in respect thereto. *Sutter v. Robinson*, 119 U. S., 541, 7 Sup. Ct. Rep., 376; *Shepard v. Carrigan*, 116 U. S., 597, 6 Sup. Ct. Rep., 493. The same principle should apply in a case like the present, where a party voluntarily resubmits his patent to the examination and revision of the patent office, and acquiesces in a rejection of certain claims thereof, or in a construction placed thereon which operates to restrict or narrow the

patent. There is no distinction, in principle, between an acquiescence in an adverse decision in order to secure a patent in the first instance, and a like acquiescence in the rejection of claims reopened and resubmitted to the jurisdiction of the patent office under reissue applications. In each case the patentee is entitled to only what the office allows. By section 8 of the patent act of 1837, it was provided that, whenever a patent should be returned for reissue, the claims thereof should be subject to revision and restriction in the same manner as were original applications for patents. This provision was substantially repeated in section 53 of the patent act of 1870, which is re-enacted in section 4916, Rev. St. While it is provided by this section that 'the surrender shall take effect upon the issue of the amended patent,' it is also further provided that on application for reissue 'the specification and claim, in every such case, shall be subject to revision and restriction in the same manner as original applications are.' These two provisions of said section were under consideration in *Peck v. Collins*, 103 U. S., 665, and in respect to the former the supreme court left open the question whether, in cases where a reissue is refused on some formal or other ground which did not affect the original claim, an applicant could have a return to his original patent, while, in respect to the latter provision, making the specifications and claims subject to revision and restriction in the same manner as original applications, the court said:

" 'But if his (the patentee's) title to the invention is disputed, and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue.'

" 'The original claims 3, 10, 11, 25 and 26, having been voluntarily resubmitted to the revising jurisdiction of the patent office by the application for reissue, which repeated them literally or in substance, and having been rejected or adjudged against the patentee, not on formal grounds, but for reasons and on reference to prior patented devices which went to his right and title to such claims, and no

appeal having been prosecuted from that decision, as the applicant could have done under sections 4909-4911, etc. of the Revised Statutes, the effect of such adverse decision by the patent office should be regarded as fatal to said claims, to the same extent as their rejection upon the original application would have been. If, as seems clear, the reissue application placed these claims within the jurisdiction and power of the patent office to revise or restrict, and the office, while possessed and in the exercise of such jurisdiction, decided against the patentee's right and title to such claims, he had two courses open to him: He could seek a reversal of the examiner's action, or acquiesce in the rejection. If he elected the latter course, and took back the original letters patent, with such adverse decision remaining in force, his action, in legal effect, operated to exclude the rejected claims as parts of the patent. The return of the letters patent, under such circumstances, could not restore validity to said claims, or reinstate them to the same position or status they occupied before the reissue application was filed. The withdrawal of the letters patent after adverse action on the claims presented should be treated as an amendment thereof, to the extent of the original claims rejected. The language of the statute conferring jurisdiction upon the patent office to revise and restrict the claims presented in such cases; the decisions of the supreme court upon the effect of acquiescence on the part of the applicants in adverse decisions and rulings of the patent office: sound principle and good policy,—support this view of the subject. Patentees should not be allowed to experiment and take chances in attempts either to secure reissues, or to extend, enlarge, or broaden their inventions, without taking the risk, and subjecting themselves to the same rules and principles which apply and govern in original applications. Our conclusion is that the adverse action of the department upon said claims, with the patentee's acquiescence therein, operated to invalidate the same. But if said claims survived the revisory action and rejection thereof by the patent office un-

der the reissue application, still the unsuccessful attempt made in that proceeding to broaden or expand said claims must, upon well-settled principles, be held to so limit and restrict their construction as to exclude what was thus rejected, and to confine them to the specific devices and combinations therein described."

In this review of the decisions—two by this court containing intimations and reserving the question, one by Judge Jackson deciding the question in the affirmative, and one by the Circuit Court of Appeals below, in which a diversity of opinion evidently obtained—it becomes important to consider, as we conceive, three substantive matters—the *extent* of the *jurisdiction* acquired by the Patent Office on an application for a reissue; the *effect* of the *action* of the Patent Office on such application; and the *nature* of the *remedy* provided for adverse action by the Patent Office.

Under the express language of the statute, and under the express decision of this court in *Allen v. Culp, supra*, no surrender of the original patent takes place on the mere application for a reissue of it. "Such surrender shall take effect upon the issue of the amended patent." When, therefore, the application was made for the reissue of the Gorham patent there was no technical surrender of it. There was, however, a *reinvestment* of the Patent Office with *jurisdiction* over the original patent and its original claims, the same as over the new matter and new claims introduced on the application for a reissue. There was a voluntary *resubmission* of the entire matter to the jurisdiction of the Patent Office.

Section 4916 of the Revised Statutes, providing that a

party whose patent is inoperative or invalid may apply for a reissue of the same, says that "the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are."

This language obviously was intended to give the Office plenary and effective *jurisdiction* over the entire subject-matter, when a party voluntarily brought his patent back and asked to have it reissued. In *every* such case the specification and claims shall be *subject to revision and restriction* in the *same* manner as *original* applications are. The language could not well have been broader. The right to revise and restrict is expressly given to the Office. There was an object in this. It was to enable the Office to review its former action and to correct mistakes. The right to a reissue *presupposes* mistakes which ought to be corrected. When the applicant represents that there are mistakes and asks to have them corrected, the Office on its part may *also* suggest and insist upon the correction of mistakes. The Office is not limited by the statute *simply* to the mistakes which the applicant points out and asks to have corrected. It is given the right to *revise* and *restrict* to the same plenary extent that it had *originally* when the application was first presented.

The nature and extent of the jurisdiction and powers of the Office in the case of original applications are well known. It may *reject* claims because anticipated by prior patents. Under the statute the same extent of power is given to the Office in reissue applications. When a patent is issued and delivered to an applicant, the Office has no further jurisdiction over it, except in interference proceedings under section 4904, Revised Statutes, unless the

applicant *voluntarily* resubmit himself, and the subject-matter of the invention, to the Office, by filing an application for a reissue. When he does this, however, the Office is again clothed with power and given the right, under the statute, to consider whether the patent ought originally to have been allowed.

The statute provides what the patentee must do to obtain a reissue of his patent. A careful reading of the statute shows that the duty of the Office, in the first instance, is to determine whether a mistake or error occurred in the original issue, and if so, whether the circumstances are such as to entitle the party to a correction of the mistake by way of a reissue of the patent; but the power of the tribunal does not end here. It may of its own accord open up the original *ex parte* case between the patentee and the public, and decide upon the original patent and revise and reverse its original rulings. In the case of the Gorham reissue application the Office decided that it was a proper case for such action. The counsel for the appellants speaks of the proceedings as the preliminary correspondence between the patentee and the Office. The proceedings under the application cannot be belittled in this manner or their effect thus avoided. It was a proceeding before a tribunal vested with great powers in hearing *ex parte* cases. The application for reissue in this case was of a most extraordinary character. As appears by the opinion and findings of the court, many new claims were introduced and the scope of the patent intended to be greatly enlarged. It will not do to say that the application for a reissue was an ill-advised action of a person ignorant of her rights, advised by a patent solicitor without legal learning, and that, when the patentee's rights had been

transferred to the present claimant, wiser counsel prevailed. We regret that the application was not certified up by the court. But an examination of the record and a reading of the opinion of Judge Jackson will show the fallacy of this pretence. The application for a reissue was in fact a cunningly contrived attempt, devised by astute attorneys, cleverly framed and artfully prepared, for the purpose of absorbing inventions in the special field to which it related which had not been presented or claimed originally. The original patent was enlarged, broadened in essential parts, and many claims, never thought of at the time of the original application and until the art had been developed, injected for the purpose of enlarging the boundaries of the patentee's monopoly far beyond its original limits. The extraordinary character of the application could not fail to excite the attention of the Office, and, by virtue of the powers vested in it, it exercised the jurisdiction clearly conferred upon it to open up the original case and challenge the validity, not only of the new claims, but of all of the old claims upon which recovery was sought to be had in the court below. The only question that remains to be considered is whether in this situation of the case the parties interested in the patent had the power to paralyze the jurisdiction of the court and terminate the proceedings by abandoning the reissue proceedings and withdrawing the original patent after a decision against them on the merits.

Every applicant for a reissue voluntarily assumes the risk of having the Office reverse its judgment and reject what it previously allowed. He runs no risk of losing his patent by a rejection on mere *formal* grounds, that do not go to the merits, as was admitted in *Peck v. Collins*

and *Allen v. Culp, supra*, but he does run the risk of losing his patent where the Office on a further investigation finds that the subject-matter of it is *met* on its merits and *anticipated* by prior patents. As long as he remains out of the Office his patent cannot be affected by the Office, except in interference proceedings; but when he *voluntarily* returns and *reinvests* the Office with jurisdiction, he must abide the consequences. Otherwise, the Office might find—as in the case under consideration—that prior patents anticipated the claims and divested them of patentable novelty, and their finding be a mere *fulmen brutum*. They might find a prior patent for the same thing, with the drawings, description and claims corresponding line for line and word for word with the drawings, description and claims of the original patent surrendered to be reissued, and yet be compelled to allow applicant, upon his withdrawing his application for a reissue, to go forth with his patent to impose upon the public who may never learn of the reissue proceedings *because they are secret*, or hear of the reference, which may be some foreign patent or publication not readily accessible to the public. To prevent this, therefore, the statute evidently intended to give the Office plenary power to act and to make its action *effective* when it discovered that its prior action was wrong.

In providing that the surrender should take effect upon the issue of the amended patent the statute evidently had the purpose and intent to keep the patent alive while it was pending in the Office for a reissue. The proceedings for a reissue might be pending two or three years. If the surrender took effect immediately upon the filing of the application for a reissue, there would therefore be a *hiatus* in the life of the patent. There would be two or

three years in which there was no patent. By keeping the patent alive this consequence would be avoided. But notwithstanding the continued technical and legal existence of the patent, the statute gave the Office complete *jurisdiction* over its subject-matter, and intended that such jurisdiction should be effective for the correction of any mistakes that might be found. Though there was no technical surrender of the patent, yet there was *jurisdiction* conferred on the part of the Office over its subject-matter—a jurisdiction conferred by the *voluntary* act of the owner of the patent. The important consideration is not whether the patent was technically *surrendered*, but whether the Office had *jurisdiction* over it, *authority* to review, *power* to revise and restrict its previous action. *Jurisdiction* and power to act, not *surrender*, is the important consideration. As the statute provides and as we have seen, such jurisdiction is full and the authority conferred on the Office plenary to take such action as further investigation might render proper. The *extent* of the *jurisdiction* of the Office was made by the statute the same in every respect as it originally had been when the application for the patent was presented in the first instance.

In perfect confidence we submit that after the Office had exercised its jurisdiction of re-examining and rejecting the *original* claims the patentee had no *right* to withdraw the patent, and the act of the Office in surrendering it was *ultra vires* and without authority of law. The case was pending; a decision had been made; that decision was in favor of the people as against the patentee. From that decision no appeal had been taken, and the act of returning the patent by some official in the Office was *ultra vires*. The act of returning was at most merely a *clerical* and not

a judicial action. It involved no decision and could not appear as a reversal of the decision already made and could have no effect upon it. The people, so far as the proceedings had progressed, had obtained a victory, and since then there has been no decision by the only tribunal authorized to reverse such decision.

It may be claimed that the original patent constituted a contract between the patentee and the government. In a sense this is true, but only in the sense that every grant involves a contract. It has been urged that the application for reissue amounted simply to negotiations, preliminary in their character, between the contracting parties looking to the amendment of the contract. This claim is wholly fallacious. As admitted above, every grant from the government to an individual involves, in a certain sense, the element of contract, but it is a contract of peculiar character and subject to conditions of its own. The granting of a corporate franchise involves the element of contract, and we may illustrate our view of the question at hand by a reference to the law of corporations, which seems analogous. In the celebrated Dartmouth College cases it was decided by this court that the granting of a franchise to a private corporation constituted a contract, which, under the Constitution of the United States, could not be impaired by the subsequent act of a state. It is a matter of common history that serious apprehension was excited by this decision by reason of the supposed dangers to public and private interests by application of this doctrine to all corporations, existing and future. But it will be remembered that an associate justice of this court pointed out that, so far as future corporations were concerned, it was quite within the power of the legislatures granting or authorizing fran-

chises thereafter to make them subject to repeal or amendment, and it is well known that since that day almost all the corporate franchises granted for private purposes throughout the United States have been made by their terms subject to repeal or amendment by the granting power. We think the law is not different in the matter of patents. The granting of a patent and its acceptance by the patentee undoubtedly involves the element of a contract, but it is a contract which, under certain circumstances, is subject, like the franchise of a corporation, to repeal or amendment. Not only may the decision of the patent tribunal be opened up before courts of competent jurisdiction, but in the case of an application for reissue the tribunal itself which originally granted the patent has the right, *by virtue of express grant of power* by Congress, to reopen the original question and subject the patent "to revision and restriction in the same manner as original applications are." As under the original application the Office had the power to determine what patents should be issued, and a contract came into being only by the inventor's acceptance of that particular patent, so when the patent was brought back to the same tribunal it became immediately subject to revision and restriction the same as almost every corporate franchise existing at the present time is subject to repeal or amendment whenever the legislature which granted or authorized it sees fit to exercise that power, subject, of course, to the limitations now well established by the courts.

There can be no question, therefore, as it seems to us, that the Office had full *power* to reject the claims of the Gorham patents on their merits, as it did, if found anticipated by prior patents. If this be so, to what conclusion does it lead us ?

The action of the Office when it rejects a claim in a re-issue application is of the same nature as when it rejects a claim on an original application. The statute says that the specification and claims shall be subject to revision and restriction "in the same *manner* as original applications are." Reissue applications are placed on precisely the same footing as original applications. They enjoy no higher *privileges* and are subject to no greater *exemptions*. In an application for a reissue the applicant presents and asks for the consideration and action of the Office on his claims contained in the reissue application. Where he repeats old claims and adds new ones, he does not and cannot ask merely for a consideration of his *new* claims. He submits *all* to the consideration and action of the Office. The Office is not restricted to a consideration of the *new* claims *only*. It is authorized—and in the discharge of its duties it is obligated—to take up and consider and act upon *all* of the claims presented, the *old* as well as the *new*. Nor has the statute drawn any distinction or recognized any difference in the *action* of the Office when acting upon old claims and when acting upon *new*. On the contrary, such action is by express language made the same in both cases.

If the action of the Office is the same when operating upon *old* claims as it is when operating upon new claims, then it is obvious that the same *effect* must be given to its action in the one case as in the other. This court has repeatedly held that where a claim is rejected, and a party acquiesces in such rejection and takes his patent without the claim, he is thereafter forever estopped either from coming back to the Office and securing such claim in a re-issue or insisting, in the courts, upon a construction of existing claims which were given him, which would make

them of equal scope and meaning as the rejected claims. This is so well established, in case of rejection and acquiescence in such rejection of claims, in the prosecution of original applications that we feel that it is wholly unnecessary to cite or quote from many decisions. We, therefore, simply quote from a recent case in which this doctrine is enunciated so as to present the exact language of the court.

In *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S., 429, this court said:

“The patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto.”

Not only is a party estopped from insisting that claims rejected by the Office and acquiesced in by him are in *existence* as claims, but he is estopped from insisting that his claims actually existing are the equivalent of the ones rejected. In short, where a claim is rejected in an original application and the applicant acquiesces in such rejection, the matter is wholly and absolutely ended, so far as such claims are concerned. The same effect, in legal contemplation, must follow the rejection of an original claim repeated in a *reissue* application, because the statute has made no *distinction* whatever between them or in the action of the Office upon them.

Nor can it be said that there is a *consideration* for acquiescence in the rejection of claims on an *original* application that does *not* exist for acquiescence in the rejection of original claims on a *reissue* application, or that appli-

cant perhaps acquiesces in the rejection of some of his claims in the former case in order to get a patent for the others, without such motive for his action in the latter, for, as a matter of fact, an applicant for a reissue may acquiesce in the rejection of some of his *original* claims in order to withdraw his patent—get it back—so as to get the benefit of the original claims which the Office has not invalidated or impeached. In the present case it appears, from the statement of the court below and from the statement of the question propounded to this court for decision, that the Examiner *allowed* some claims, “*both old and new.*” When the owner of the Gorham patent, therefore, decided to acquiesce in the rejection of some of his old claims as well as the new, he was *enabled* to get his patent back with the old claims, *some* of which had *not* been affected by the action of the Office. He was willing to acquiesce in the action of the Office in order to get a patent for *some* good claims still remaining in it, just as an applicant in an original application is willing to acquiesce in a rejection of some of the claims in order to get a patent containing the others. In both cases there is precisely the same *consideration* for acquiescence in the rejections of the Office—the getting of a patent with *some* unrejected claims in it. But *acquiescence* is not a necessary element for consideration. A tribunal the virtue of whose decisions depends upon the acquiescence of the suitors who appear before it, must be weak indeed. *Jurisdiction* and *decision* are the main things to be considered.

It seems to us, therefore, that the *effect* of the official action in the rejection of the original claims resubmitted to the Office in an application for a reissue is precisely the same as the action of the Office on original applica-

tions, and should be effectuated by the courts to the same extent.

The nature of the *remedy* provided for the rejection of the claims on reissue applications is the same as that provided for an applicant on original applications. He has a right of *appeal* from the action of the Examiner to the appellate tribunals in the Patent Office, and from the final action of the Office to the courts of equity under Section 4915 of the Revised Statutes. As is well known, an appeal lay from the action of the Primary Examiner rejecting claims to the Board of Examiners-in-Chief, and from the Board of Examiners-in-Chief to the Commissioner in person, and from the Commissioner in person to the Supreme Court of the District of Columbia; and if none of these appellate tribunals give the applicant what he considers that he is entitled to, "the applicant may have remedy by a bill in equity." This court has frequently recognized that a party should resort to his remedies by appeal if he is dissatisfied with the action of the Office in rejecting his claims.

In *Mahn v. Harwood*, 112 U. S., 359, this court said:

"The proper remedy of the patentee when a claim applied for is rejected, is an appeal."

In *Shepard v. Corrigan*, 116 U. S., 598, this court said:

"If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal."

In the case under consideration no appeal was taken. The applicant for a reissue disregarded the plain remedy proper for the correction of any error, if there were one, in the action of the Office in rejecting original claims 3, 10 and 11, among others, repeated in his application for

a reissue. He *acquiesced* in the decision of the Office, *abandoned* his application for a reissue, took back his original patent and has been insisting in the courts that claims are valid which the Office rejected as invalid, as anticipated, as lacking in patentable novelty. If dissatisfied with the decision of the Office, why did he not appeal? The court says that that is the *proper* remedy. On a decision of the Office against him he goes into the courts and insists that such decision is not binding upon him and has no force or effect. It is as though a party acquiesced in the decision of a court of law when remedies by appeal are provided, and afterwards, in another court, when confronted by such decision, claimed that it amounted to nothing. We are asking that *effect* be given to the decision of the Office. We are relying upon it as a *bar* to the maintenance of this suit—as an estoppel by *record*. Appellant seeks to avoid such decision—attack it *collaterally*. Having ignored his remedy by appeal, he asked the courts, and is asking this court, to review the action of the Office in this *collateral* proceeding and regard it as naught. As well might a patentee who had acquiesced in a rejection of claims on an original application and taken his patent for other claims ask the courts to find that the action of the Office in rejecting his claims was wrong, and to give such effect to his claims allowed as would give him the benefit of his rejected claims. The courts have uniformly refused to do this. They have held that the action of the Office is *conclusive*. They have not attempted to go behind the Office. They have accepted applicant's acquiescence and omission to appeal—to pursue the remedies provided—as conclusive upon him in all proceedings thereafter in the courts and everywhere.

We submit and insist, therefore, that the remedy open to the owner of the Gorham patent, if he was dissatisfied with the action of the Office in rejecting the original claims 3, 10 and 11 on his application for a reissue, was by appeal; that having acquiesced in the action of the Office and failed to avail himself of the remedies provided for such cases, the decision of the Office against him has become absolute and conclusive in all *collateral* proceedings and elsewhere; and that the Gorham patent must be considered precisely the same as if claims 3, 10 and 11 had been *erased* by the Office before returning the original patent, or, as expressed by Judge Jackson, the withdrawal of the letters patent after rejection and without appeal "should be treated as an amendment thereof to the extent of the original claims rejected."

Respectfully submitted,

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Counsel for Appellees.

McCORMICK HARVESTING MACHINE CO. v.
AULTMAN.

SAME v. AULTMAN-MILLER COMPANY.

CERTIFICATE FROM THE CIRCUIT COURT OF APPEALS FOR THE
SIXTH CIRCUIT.

Nos. 130, 131. Argued December 1, 2, 1897. — Decided March 21, 1898.

If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the primary examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, the owner of the patent does not, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue ; as the Patent Office, by the issue of the original patent, had lost jurisdiction over it, and did not regain it by the application for a reissue.

This was a question certified to this court by the Circuit Court of Appeals for the Sixth Circuit, involving the authority of a primary examiner of the Patent Office to reject as invalid claims of an original patent which were incorporated in an application for a reissue.

It appears that the McCormick Harvesting Machine Company filed a bill in equity in the United States Circuit Court for the Northern District of Ohio against C. Aultman et al., and also one against the Aultman-Miller Company, in each of

Statement of the Case.

which it was sought to restrain the defendant from the future infringement of two patents covering automatic twine binders for harvesting machines. As the interests of the several defendants were closely identified the two cases were heard together.

The question certified involves only patent No. 159,506, issued to Marquis L. Gorham, February 9, 1875, and the other patent sued upon will therefore not be considered. The record shows that there was filed in the Patent Office by the executrix of Gorham an application for a reissue of this patent, in which were included several claims of the original patent, as well as many new claims. Upon consideration, the assistant or primary examiner decided that claims 3, 10, 11, 25 and 26 of the original patent should be rejected for want of patentable novelty, and reference was made to prior patented devices. No appeal was taken from this decision, and subsequently, in compliance with a request, the original patent was returned to the plaintiff corporation, which had become the owner thereof. Thereafter these suits were brought against the defendants upon the original patent.

In the Circuit Court it was decided, that as the original claims 3, 10, 11, 25 and 26 had been determined by the examiner to be invalid, and no appeal had been taken from that decision, but the same had apparently been acquiesced in, the adverse action must be regarded as fatal to the claims in question, and to the same extent as if the rejection had been incident to the original application for the patent. 58 Fed. Rep. 778.

Upon appeal the Circuit Court of Appeals decided that there was no infringement by the defendants as to claims 25 and 26, but that there was infringement of claims 3, 10 and 11 of the original patent, unless it should be determined that they were invalidated by their being rejected by the examiner upon an application for a reissue of the same; and, desiring instruction upon this point, it certified to this court the following question: "If the owner of a patent applies to the Patent Office for a reissue of it, and includes among the claims in the application the same claims as those which were included in

Opinion of the Court.

the old patent, and the primary examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent, the return of which he procures from the Patent Office, invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?"

Mr. Robert H. Parkinson for appellant.

Mr. Thomas A. Banning, (with whom was *Mr. Ephraim Banning* on the brief,) and *Mr. Edmund Wetmore* for appellees.

MR. JUSTICE BROWN, after stating the case, delivered the opinion of the court.

The validity of the claims in question depends upon the view taken of the action of the examiner in rejecting them when incorporated in an application for a reissue of the patent, upon the ground that the claims were wanting in patentable novelty, as evidenced by prior patents cited by him. No appeal was taken from this decision, and the matter lay in abeyance for nearly two years before the plaintiff corporation, which had in the meantime become the owner of the patent, abandoned the application for a reissue and requested and obtained from the Patent Office the return of the original patent.

It has been settled by repeated decisions of this court that when a patent has received the signature of the Secretary of the Interior, countersigned by the Commissioner of Patents, and has had affixed to it the seal of the Patent Office, it has passed beyond the control and jurisdiction of that office, and is not subject to be revoked or cancelled by the President, or any other officer of the Government. *United States v. Schurz*, 102 U. S. 378; *United States v. Am. Bell Telephone Co.*, 128

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U. S. 315, 363. It has become the property of the patentee, and as such is entitled to the same legal protection as other property. *Seymour v. Osborne*, 11 Wall. 516; *Cammeyer v. Newton*, 94 U. S. 225; *United States v. Palmer*, 128 U. S. 262, 271, citing *James v. Campbell*, 104 U. S. 356.

The only authority competent to set a patent aside, or to annul it, or to correct it for any reason whatever, is vested in the courts of the United States, and not in the department which issued the patent. *Moore v. Robbins*, 96 U. S. 530, 533; *United States v. Am. Bell Telephone Co.*, 128 U. S. 315, 364; *Michigan Land and Lumber Co. v. Rust*, 168 U. S. 589, 593. And in this respect a patent for an invention stands in the same position and is subject to the same limitations as a patent for a grant of lands. The power to issue either one of these patents comes from Congress and is vested in the same department. In the case of a patent for lands it has been held that when one has obtained a patent from the Government he cannot be called upon to answer in regard to that patent before the officers of the Land Department, and that the only way his title can be impeached is by suit. *United States v. Stone*, 2 Wall. 525, 535; *Iron Silver Mining Co. v. Campbell*, 135 U. S. 286; *Noble v. Union River Logging Railroad*, 147 U. S. 165. But a suit may be maintained by the United States to set aside a patent for lands improperly issued by reason of mistake, or fraud; but only in the case where the Government has a direct interest, or is under obligation respecting the relief invoked. *United States v. Missouri, Kansas & Texas Railway*, 141 U. S. 358.

While a patent for a grant of lands is absolutely free from the future control of the officers of the Land Department after it has once issued, and jurisdiction over the matter cannot again be obtained, this is subject to a single qualification in the case of a patent for an invention where the patentee, his legal representatives or assigns, find the original patent inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new (provided the error has arisen through inadvertence,

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accident or mistake, and without fraudulent or deceptive intention). In such case a reissue will be granted by the Commissioner upon the surrender of the patent, but such surrender takes effect only upon the issue of the amended patent. This provision is embodied in Rev. Stat. § 4916, which also declares that "the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications, . . . but no new matter shall be introduced into the specifications."

The plain purpose of this section is to give the patentee an opportunity to make valid and operative that which was before invalid and inoperative; invalid, because it claimed as new that which had been previously invented or used by the public; inoperative, because the specification was defective or insufficient. New matter cannot be introduced, nor can the scope of the invention be enlarged. All that the applicant can do is to so amend his patent as to enable him to receive some practical and beneficial result from his actual invention, of which he has been deprived by defects or omissions in the original patent. The object of a patentee applying for a reissue is not to reopen the question of the validity of the original patent, but to rectify any error which may have been found to have arisen from his inadvertence or mistake. But until the amended patent shall have been issued the original stands precisely as if a reissue had never been applied for, (*Allen v. Culp*, 166 U. S. 501, 505,) and must be returned to the owner upon demand. The fact that the rules of the Patent Office require that the original patent should be placed in its custody for the purpose of surrendering it upon the issue of an amended patent gives that department no right to the possession of it upon the rejection of the application for a reissue. If the patentee abandoned his application for a reissue, he is entitled to a return of his original patent precisely as it stood when such application was made, and the Patent Office has no greater authority to mutilate it by rejecting any of its claims than it has to cancel the entire patent.

In *Peck v. Collins*, 103 U. S. 660, an application for reissue made under the laws in force in 1866 was held to absolutely

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extinguish the original patent. Subsequent to that time the law of 1870, of which Rev. Stat. § 4916 forms a part, was passed. Mr. Justice Bradley, in discussing the clause in that section which declares that the surrender "shall take effect upon the issue of the amended patent," said: "What may be the effect of this provision in cases where a reissue is refused it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a reissue is refused on some formal or other ground which does not affect the original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue." This same question was considered but not decided in *Eby v. King*, 158 U. S. 366; and in *Allen v. Culp*, 166 U. S. 501, 505, it was held that if the original application for a reissue be rejected the original patent stands precisely as though a reissue had never been applied for; but the effect of the refusal of the reissue upon some ground equally affecting the original patent was not considered.

In neither of these cases was this court called upon to decide the question which has been certified, and the expression of opinion in *Peck v. Collins*, relied upon by the defendants, must be considered merely a *dictum*, and lacking the force of a judicial determination.

In the case under consideration the examiner acted upon the application as if it were a new proceeding, and dealt with it as the evidence before him seemed to warrant, but his action in rejecting some of the claims which had been repeated from the original patent did not affect that patent. It is true that it was within his power to reject any claims contained in the application for a reissue which he judged to be invalid, whether contained in the original patent or not. It is also true that the reasons given for the rejection of such claims might apply equally to the same claims contained in the original patent; but with respect to such claims he was *functus officio*. His opinion thereon was but his personal opinion, and however persuasive it might be, did not oust the

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jurisdiction of any court to which the owner might apply for an adjudication of his rights, and as the examiner had no authority to affect the claims of the original patent, no appeal was necessary from his decision.

Had the original patent been procured by fraud or deception it would have been the duty of the Commissioner of Patents to have had the matter referred to the Attorney General with the recommendation that a suit be instituted to cancel the patent; but to attempt to cancel a patent upon an application for reissue when the first patent is considered invalid by the examiner would be to deprive the applicant of his property without due process of law, and would be in fact an invasion of the judicial branch of the government by the executive.

Our conclusion upon the whole case is that, upon the issue of the original patent, the Patent Office had no power to revoke, cancel or annul it. It had lost jurisdiction over it, and did not regain such jurisdiction by the application for a reissue. Upon application being made for such reissue the Patent Office was authorized to deal with all its claims, the originals as well as those inserted first in the application, and might declare them to be invalid, but such action would not affect the claims of the original patent, which remained in full force, if the application for a reissue were rejected or abandoned.

The validity of the claims, so far as their merits are concerned, has been sustained by the Circuit Court of Appeals, and, as the original patent must stand precisely as though a reissue had never been applied for,

The question certified to this court must be answered in the negative.